Supreme Court, U.S.
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No. 03-

IN THE

Supreme Court of the United States

LAFACE RECORDS, ARISTA RECORDS, INC., BMG ENTERTAINMENT, and OUTKAST,

Petitioners,

v.

ROSA PARKS,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether the lower court unconstitutionally allows public figures to use trademark and right of publicity law to censor speech.

2. Whether the lower court's failure to observe the distinction between commercial and non-commercial speech resulted in creation of a "mutant" and unprecedented civil action that unconstitutionally restricts speech about celebrities.

3. Whether the lower courts' adoption of conflicting permissive and restrictive tests for measuring Trademark Act and right of publicity claims against First Amendment standards threatens constitutionally-protected expression.

STATEMENT PURSUANT TO RULE 29.6

Petitioner LaFace Records states that its ultimate parent corporation is Bertelsmann AG and that it is not owned in whole or in part by any publicly held company.

Petitioner Arista Records states that its ultimate parent corporation is Bertelsmann AG and that it is not owned in whole or in part by any publicly held company.

Petitioner BMG Entertainment states that its ultimate parent is Bertelsmann AG and that it is not owned in whole or in part by any publicly held company.

Petitioner OutKast states that it has no corporate parent and that it is not owned in whole or in part by any publicly held company.

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STATEMENT OF JURISDICTION

The court of appeals entered its opinion and order on May 12, 2003 and denied rehearing *en banc* on July 2, 2003. Petitioners invoke this Court's jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This case involves the Free Speech Clause of the First Amendment to the United States Constitution and Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a), both of which are reprinted in the Appendix at 83a-84a.

STATEMENT OF THE CASE

1. *Introduction and Summary*

This case presents the following question: Does the First Amendment permit a writer to use a public figure's name symbolically as the title of a work that is perceived as "antithetical" to the image or "qualities" of the public figure? The Sixth Circuit's decision in this case invites a jury to impose liability if it decides that the popular song entitled "Rosa Parks" is "antithetical to the qualities identified with Rosa Parks." *Parks v. LaFace Records*, 329 F.3d 437, 454 (6th Cir. 2003) (Pet. App. 31a).

The record is clear: There is an undeniable and undisputed "relationship" between the title "Rosa Parks" and a song whose chorus repeats ten times "everybody move to the back of the bus." That phrase, "back of the bus," makes an immediate connection with Rosa Parks for anyone who has ever heard of Rosa Parks — whether the phrase is spoken once or ten times. The Sixth Circuit did not disagree, observing that it mattered not whether "the phrase [back of the bus] is repeated ten times or fifty times." *Id.* at 453 (Pet. App. 28a). Rather, for the Sixth Circuit "the **question presented** is how the symbol of Rosa Parks, a symbol of 'freedom, humanity, dignity and strength' is artistically related to the content of a song that appears to be diametrically opposed to those qualities." *Id.* at 456 (emphasis added) (Pet. App. 34a). The Sixth Circuit made the aesthetic judgment that the song was "nothing more and nothing less than a paean announcing the triumph of superior people in the entertainment business over inferior people in that business." *Id.* at 453 (Pet. App. 27a-28a).

Songs such as "Rosa Parks" indisputably receive First Amendment protection, *see Ward v. Rock against Racism*, 491 U.S. 781, 790 (1989), regardless of their content. This court has rejected out of hand any effort to "ensure that a symbol" — be it a flag, Reverend Jerry Falwell or Rosa Parks — "be used to express only one view of that symbol or its referents." *Texas v. Johnson*, 491 U.S. 397, 417 (1989); *see also Hustler Magazine v. Falwell*, 485 U.S. 46 (1988).

The Sixth Circuit purports to adopt the speech protective test set forth by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). But under *Rogers*, a title receives full First Amendment protection unless it has "**no** artistic relevance to the underlying work **whatsoever**." *Id.* at 999 (emphasis added). The Sixth Circuit decision, in vivid contrast, invites a jury to compare a work's artistic content to the celebrity's image, at one point going so far as to suggest

that a jury might decide whether the title is "reasonably 'artistic.'" *Parks*, 329 F.3d at 450 (Pet. App. 22a).[1] As a result, the Sixth Circuit ignores this Court's historic warning (albeit in the context of a copyright case) that the judiciary is ill equipped to decide what is and is not "art." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). More importantly, the Sixth Circuit blurs the bright-line rule requiring judicial evaluation of constitutional facts, *see Bose Corp. v. Consumers Union of the United States, Inc.*, 466 U.S. 485, 505 (1984), leaving to "the jury far more leeway to act as censors than is consistent with the protection of the First and Fourteenth Amendments." *Monitor Patriot Co. v. Roy*, 401 U.S. 265, 275 (1971). The result will be to constrict the "breathing space" required for freedom of expression, *see New York Times v. Sullivan*, 376 U.S. 254, 272 (1964), as artists and publishers try to guess how a jury might decide "whether [the] title is reasonably 'artistic,'" *Parks*, 329 F.3d at 450 (Pet. App. 22a), before inevitably opting for the safest artistic speech.

The concerns of *Monitor* and *New York Times* are real and present in this case. The risks are obvious from the Sixth Circuit's opinion, which disparages the song's "profanity," "explicit language," "parental warning," "pure egomania" and "message" of the inferiority and "lesser quality" of bands that compete with OutKast. 329 F.3d at 452-54 (Pet. App. 27a-31a). The Sixth Circuit panel's ultimate view of the song was thinly concealed in its final musing as to whether it "personally regard[ed] [the song] as repulsive trash or a work of genius." *Id.* at 462 (Pet. App. 49a). With all due respect, it is just such judgments that the First Amendment forbids judges and juries to make as a predicate for enjoining protected expression.

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1. Thus, in purporting to reject the so-called "alternative avenues" test (which prohibits use of a celebrity name if there is an alternative), the Sixth Circuit said that such a test would ask courts to determine "not just whether a title is reasonably 'artistic' but whether a title is 'necessary' to communicate the idea." *Id.* at 450 (Pet. App. 22a).

2. *Background of the Case*

The plaintiff in this case, Ms. Rosa Parks, is a public figure whose well-deserved fame "arose from her heroic stance against racial inequality in the South when on December 1, 1955, in Montgomery, Alabama, she refused to give up her seat to a white passenger and move to the back of the bus." *Parks v. LaFace Records*, 76 F. Supp.2d 775, 777 (E.D. Mich. 1999) (Pet. App. 53a). As a result of this courageous act, Ms. Parks and the phrase "back of the bus" have become inextricably linked: part of the lexicon of our American history.[2]

The defendants (and petitioners before this Court) are artists, entertainers, and distributors of popular music. In 1998, they released an album entitled *Aquemini*, consisting of a total of fifteen songs. Track number 3, entitled "Rosa Parks," contains the lyrics recited in the Sixth Circuit opinion in this case. (*See* 329 F.3d at 442-443; Pet. App. 4a-7a). While Ms. Parks is not mentioned by name in the lyrics, the song's chorus is comprised of the words "Ah, ha, hush that fuss. Everybody move to the back of the bus." This chorus is repeated a total of ten times.

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2. Reference materials repeatedly associate Ms. Parks with her refusal to move to the back of the bus. *See Time*, June 14, 1999, at 3 ("[Ms. Parks] refuses to go the **back of the bus** and is arrested . . ." (emphasis added)); 145 Cong. Rec. S2278 (daily ed. Mar. 4, 1999) (statement of Sen. Abraham) ("Rosa Parks refused to . . . go to the **back of the bus**.") (emphasis added). (R. 15: Plaintiff's Stipulated Facts, Exhs. B, C; JA0047, JA0054). *See also* 7 *Grolier Library of Women's Biographies* 167-68 (1998); *Black Women in America: An Historical Encyclopedia* 907 (Hine et al., eds. 1993); *Academic American Encyclopedia* 92 (1997). (R. 25: Defendants' App. Exhs. A1-A3; JA0156 - JA0166). In fact, a search in the NEXIS/LEXIS news database for the name "Rosa Parks" appearing within 10 words of the phrase "back of the bus" produces no fewer than 337 references merely within the years 1990 to 1997 (the year before the album at issue in this litigation was released). (R. 25: Defendants' App. Exh. A4; JA0168).

The band OutKast, the *Aquemini* album, and the song "Rosa Parks" have all received widespread critical acclaim within the music industry and from the general public, including for the music's "social consciousness."[3] The song "Rosa Parks" was nominated for a Grammy Award. (*See* R. 15: Plaintiff's Stipulated Facts ¶ 43; JA0039).

On April 1, 1999, Ms. Parks filed suit in the Wayne County Circuit Court for the State of Michigan against the band OutKast, LaFace Records, Arista Records, and BMG Entertainment (collectively, "Defendants").[4] Ms. Parks' suit alleged that by naming their song "Rosa Parks" Defendants

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3. *See* Chris Vognar, *Dallas Morning News*, Dec. 24, 1998, at 27A. *See also Los Angeles Times*, Sept. 27, 1998, at 68 ("Tackling topics such as emancipation, drug addiction and problematic relationships [Outkast] explore[s] the bleakest aspects of humanity while encouraging their listeners to examine themselves"); Greg Kot, *Chicago Tribune*, Dec. 20, 1998, at C12 ("[Outkast's] spirited vocals are performed against a backdrop of live instruments that draw on a century of tradition. . . ."); "The Albums Of The Year," *University Wire*, Dec. 8, 1998 ("This album features thought-provoking lyrics, catchy beats and choruses and a comprehensive understanding of the current state of Black America. . . ."); Sheila Simmons, "Outkast: A Bridge For The Ages," *The Plain Dealer*, Mar. 10, 1999, at 3G ("Over funky, soulful beats, Outkast tackled issues about street survival as well as diplomas and SATs. . . . **The line, from the album's debut single, 'Rosa Parks' . . . taught younger listeners about the civil rights activist for whom the song is named.**"); Michael Hewlett, "Innovative Rap Duo Is Outkast In Name Only," *Greensboro News and Record*, Mar. 11, 1999, at 4 ("Musically innovative, the group sneaks in positive messages. . . ."); Sonia Murray, *Atlanta Journal and Constitution*, Oct. 1, 1998, at 4E ("**And, no, Outkast isn't about shooting and robbing like much West Coast gangster rap**. . . .") (all emphases added).

4. Antonio "L.A." Reid and Kenny "Babyface" Edmonds are listed as defendants in the case caption, but were never served and are not a part of this lawsuit in their individual capacity, as the Sixth Circuit noted. 329 F.3d at 442 n.1 (Pet. App. 4a).

violated her publicity rights, engaged in unfair competition, and defamed her, among other state law claims. Defendants properly removed the case to the United States District Court for the Eastern District of Michigan. On November 18, 1999, the District Court entered summary judgment in Defendants' favor on all counts.

In reaching its conclusion, the District Court followed *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). The *Rogers* court was faced with claims by dancing great Ginger Rogers, who alleged, *inter alia*, violation of the Trademark Act and her right of publicity by a film entitled "Ginger and Fred" that was not "about" her, or her partner Fred Astaire, but rather was about two cabaret dancers who became known as "Ginger and Fred." *Id.* at 997. The *Rogers* court announced and applied a legal standard shielding artistic uses of celebrity names in titles unless the celebrity's name has "no artistic relevance to the underlying work whatsoever." *Id.* at 999. Applying this legal standard, the District Court properly reasoned that:

> There can be no reasonable dispute that Rosa Parks is universally known for and commonly associated with her refusal in late 1955 to . . . obey the segregation laws in Montgomery, Alabama and "move to the back of the bus." The song at issue makes unmistakable reference to that symbolic act a total of ten times. Admittedly, the song is not about [Ms. Parks] in a strictly biographical sense, but it need not be. Rather, defendants' use of plaintiff's name, along with the phrase "move to the back of the bus," is metaphorical and symbolic. As a matter of law, this obvious relationship between the content of the song and its title bearing plaintiff's name renders the right of publicity inapplicable.

76 F. Supp.2d at 780 (Pet. App. 60a). The District Court likewise dismissed Ms. Parks' Trademark Act claims because the title

was found to have artistic relevance to the underlying work. 76 F. Supp.2d at 782-83 (Pet. App. 64a-67a). The District Court refused the plaintiff's invitation to render artistic judgment on Defendants' musical work, noting that:

> It is fundamental that courts may not muffle expression by passing judgment on its skill or clumsiness, its sensitivity or coarseness; nor on whether it pains or pleases. It is enough that the work is a form of expression deserving of substantial freedom both as entertainment and as a form of social and literary criticism.

76 F. Supp.2d at 780-81 (Pet. App. 60a) (quoting *University of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp.*, 256 N.Y.S.2d 301, 307, *aff'd*, 259 N.Y.S.2d 832 (1965)).[5]

The Sixth Circuit reversed entry of summary judgment for both the Trademark Act and right of publicity claims in an opinion charged with improper aesthetic judgments about the song's "profanity," "explicit language," "parental warning," "pure egomania" and "message" of the inferiority and "lesser quality" of OutKast's competitors. 329 F.3d at 452-54 (Pet. App. 27a-31a).

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5. The District Court also dismissed Ms. Parks' defamation claim, concluding that the song

> manifestly contains no factual statements, false or otherwise, about plaintiff. . . . Rather, the song only references plaintiff indirectly through the refrain 'Ah ha, hush that fuss, Everybody move to the back of the bus.' Furthermore, because no portion of defendants' song can be construed as a false factual statement about plaintiff, she, as a public figure, could never prove actual malice.

76 F. Supp.2d at 785-86 (Pet. App. 72a-73a). Finally, the District Court dismissedMs. Parks' remaining state law claims for intentional infliction of emotional distress, intentional interference with business relations, unjust enrichment, negligence, and conspiracy.

REASONS FOR GRANTING THE PETITION

1. The lower court unconstitutionally allows public figures to use civil law — in this case, trademark law and the right of publicity — to censor speech.

New York Times v. Sullivan, of course, dealt with defamation, but the Court's reasoning was not confined to that tort:

> [W]e are compelled by neither precedent nor policy to give any more weight to the epithet 'libel' than we have to other 'mere labels' of state law. Like insurrection, contempt, advocacy of unlawful acts, breach of the peace, obscenity, solicitation of legal business, and the various other formulae for the repression of expression that have been challenged in this Court, libel can claim no talismanic immunity from constitutional limitations. It must be measured by standards that satisfy the First Amendment.

Id. at 269 (internal citations and footnotes omitted). Thus, in *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988), this Court concluded that the tort of intentional infliction of emotional distress could not be used by a public figure to penalize offensive speech.[6]

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6. Some lower courts have been similarly vigilant against civil actions designed to punish or restrict speech. *See Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 522 (4th Cir. 1999) (plaintiff's reliance on duty of loyalty and trespass theories to challenge undercover investigative report was "an end-run around First Amendment strictures . . . foreclosed by *Hustler*."); *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d 1180 (9th Cir. 2001) (applying *New York Times v. Sullivan* to a right of publicity challenge to a magazine article).

The parallels between this case, *Sullivan*, and *Hustler* are striking: *Sullivan* involved defamation (also pled by Ms. Parks in this suit); *Hustler* the tort of intentional infliction of emotional distress (also pled by Ms. Parks). In all three cases, a public figure uses a civil tort theory to suppress speech that is critical, offensive or simply unwelcome; in all three cases, the ordinary standards for determining liability are inadequately speech-protective. Only the *Rogers* test of **no** artistic relevance supplies constitutional protection coextensive with *Sullivan* and *Hustler*.

Celebrity and public figure identities are important elements of speech. *See ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 933 (6th Cir. 2003) ("Through their pervasive presence in the media, sports and entertainment celebrities come to symbolize certain ideas and values. Celebrities, then, are an important element of the shared communicative resources of our cultural domain.") (quoting *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 972 (10th Cir. 1996)). *See also White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1512 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) ("Trademarks are often reflected in the mirror of our popular culture.") (listing numerous examples of trademarks incorporated into titles of literary, cinematic, and musical works).

Given the growing importance of celebrity identities and trademarks in expressive communications, it is important to adhere to a recurring principle in this Court's First Amendment jurisprudence: Legal standards protecting freedom of expression must be clear in order to afford speech "breathing space." *Sullivan*, 376 U.S. at 272. For that reason, the state law requirement of factual error was deemed inadequately protective of "breathing space" in *Sullivan*, and "outrageousness" did not pass constitutional muster in *Hustler*. *See Hustler*, 485 U.S. at 54 ("'Outrageousness'

in the area of political and social discourse has an inherent subjectiveness about it which would allow a jury to impose liability . . . on the basis of their dislike of a particular expression.").

Under the lower court's opinion in this case, trademark and publicity law empower public figures to subject displeasing expression to a formless and subjective inquiry: Is the content of the expression consistent with the public figure's "qualities"? This misguided approach surfaces throughout the Sixth Circuit's opinion:

- "In lyrics that are laced with profanity and in a 'hook' or chorus that is pure egomania, many reasonable people could find that this is a song that is clearly antithetical to the **qualities** identified with Rosa Parks." *Parks*, 329 F.3d at 454 (emphasis added) (Pet. App. 30a-31a).

- "It is titled *Rosa Parks*, and it is difficult to equate OutKast's feeling of superiority, metaphorically or in any other manner, to the **qualities** for which Rosa Parks is known around the world." *Id.* (emphasis added) (Pet. App. 31a).

- "**[T]he question presented** is how the symbol of Rosa Parks, a symbol of 'freedom, humanity, dignity, and strength' is artistically related to the content of a song that appears to be diametrically opposed to those **qualities**." *Id.* at 456 (emphasis added) (Pet. App. 34a).

- "The lyrics' sole message is that OutKast's competitors are of lesser quality and, therefore, must 'move to the back of the bus,' or in other words 'take a back seat.' We believe that reasonable persons could conclude that there is no relationship of any kind between Rosa Parks' name and the **content of the song** — a song that is nothing more and nothing less than a paean announcing

> the triumph of superior people in the entertainment business over inferior people in that business." *Id.* at 452-53 (emphasis added) (Pet. App. 27a-28a).[7]

Petitioners respectfully submit that free-wheeling jury comparisons of an artistic work to a celebrity's "qualities" will pose the same kind of threat to artistic speech as was recognized and thwarted by this Court in *Sullivan* and *Hustler*.

Proper application of the *Rogers* test to artistic speech provides the bright-line, speech-protective rule long mandated by this Court's First Amendment jurisprudence. The Sixth Circuit's misapplication of Rogers, however, not only blurs that line: it conflicts with this Court's historic instructions that reviewing courts must make an independent assessment of "constitutional facts" where First Amendment rights hang in the balance.[8] By treating the issue of "artistic relevance" as one of historical fact for the jury to decide (rather than a mixed question for the court), the Sixth Circuit subjects the First Amendment rights of artists to myriad and unpredictable outcomes. To be sure, some artists can appeal, wasting their money and the judiciaries' resources as each reviewing court "make[s] an independent

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7. Significantly, the book *On the Bus With Rosa Parks*, an anthology of poems by former U.S. poet laureate Rita Dove, is not "about" Rosa Parks. Rather, the book uses the name in the title metaphorically, just as petitioners have done in their song. The only difference is in the content — and the fact that Ms. Parks has not chosen to challenge it.

8. More than eighty years ago, Justice Brandeis, in a characteristically prescient dissenting opinion joined by Justice Holmes, warned that a judge must not "abdicate" the duty of assessing, independently of the jury, constitutional facts affecting freedom of speech. *Schaefer v. United States*, 251 U.S. 466, 483 (1920).

examination of the whole record so as to assure [itself] that the judgment does not constitute a forbidden intrusion on the field of free expression." *Sullivan*, 376 U.S. at 285. But this "constitutional responsibility that cannot be delegated to the trier of fact . . . ," *Bose*, 466 U.S. at 501, *also* applies fully at the summary judgment stage, as recognized in *Rogers*, 875 F.2d at 999 and *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002), *cert. denied*, 123 S. Ct. 993 (2003).[9] If courts fail to fulfill that duty, then to paraphrase *Riley v. National Fed'n of the Blind*, 487 U.S. 781, 794 (1988), "the [songwriter] must bear the costs of litigation and the risk of a mistaken adverse finding by the factfinder," a result which "must necessarily chill speech in direct contravention of the First Amendment's dictates."[10]

In sum, allowing a jury to decide "artistic relevance" under the Panel's formulation of *Rogers* (or to decide whether the title is reasonably 'artistic'" under the Panel's alternative formulation) creates intolerable risks to the First Amendment right to use a controversial title with an expressive work. This is because application of the Panel's "artistic relevance"

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9. The *Rogers* court found summary judgment proper although 38% of those surveyed thought Ginger Rogers had something to do with the movie "Ginger and Fred" and 14% thought she was involved in making the film. For the Court, the risk the public would misunderstand Ms. Rogers' role from the title was "so outweighed by the interests in artistic expression as to preclude application of the Lanham Act." *Rogers*, 875 F.2d at 1001 & n.8.

10. In a recent case, this Court dismissed certiorari as improvidently granted because of the case's procedural posture. *See Nike, Inc. v. Kasky*, 123 S. Ct. 2554 (2003). Shortly thereafter, Nike settled, paying $1.5 million rather than defend its free speech rights. *See* Adam Liptak, *Nike Move Ends Case Over Firms' Free Speech*, N.Y. TIMES, Sept. 13, 2003, at A8. The Sixth Circuit's distortion of the *Rogers* test forces artists and any others who use or want to use a celebrity's name for expressive purposes to face a stark choice: keep silent or pay up to avoid protracted litigation.

standard — not to mention its "reasonably artistic" standard — has "an inherent subjectiveness . . . which would allow a jury to impose liability on the basis of the jurors' tastes or views, or perhaps on the basis of their dislike of a particular expression." *See Hustler*, 485 U.S. at 55. As this Court has stated in a closely analogous context:

> [S]uch a standard applied by a jury under the preponderance-of-the-evidence test, is unlikely to be neutral with respect to the content of speech and holds a real danger of becoming an instrument for the suppression of those 'vehement, caustic, and sometimes unpleasantly sharp attacks' which must be protected if the guarantees of the First and Fourteenth Amendments are to prevail.

Monitor, 401 U.S. at 276-77 (quoting *Sullivan*, 376 U.S. at 270). To avoid these risks, a court must adopt in fact, then rigorously apply, the "any artistic relevance" standard at the summary judgment stage — just as the district judge below did in putting aside her personal views of Defendants' song and "regrettably" granting summary judgment to Defendants. 76 F. Supp.2d at 778 (Pet. App. 53a).

2. The Sixth Circuit's failure to observe the distinction between commercial and non-commercial speech resulted in creation of a "mutant" and unprecedented civil action that unconstitutionally restricts speech about celebrities.

Many lower courts, including the Sixth Circuit, have found that the Trademark Act may only be applied to commercial speech. *See, e.g., The Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003) ("The Lanham Act is constitutional because it only regulates commercial speech"). Within the realm of purely commercial speech, the Trademark Act's permissive standards for imposition of liability and its

robust remedies serve the goal of providing accurate information to consumers and promoting competition, with no countervailing constitutional considerations.[11] But when applied to fully-protected speech in movies and songs — including to their titles — rigorous application of the *Rogers* test is necessary:

> Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles. **Titles**, like the artistic works they identify, **are of a hybrid nature**, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined. Film-makers and **authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works**. Furthermore, their interest in freedom of artistic expression is shared by their audience. The subtleties of a title can

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11. For example, trademark liability may be imposed whenever a "likelihood of confusion" is found, *see* 15 U.S.C. §§ 1114, 1125(a), a standard which requires only that a significant number of consumers (not a majority) are likely to be misled. *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:2, at 23-11 (4th ed. 2002) ("If an appreciable number of reasonable buyers are likely to be confused . . . there is liability for trademark infringement. . . . An appreciable or substantial number of confused consumers does not necessarily mean a majority of such customers."). And, of course, preliminary and permanent injunctions are available and routinely granted in trademark cases. *See* 15 U.S.C. § 1116 (authorizing injunctive relief); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 35 cmt. b (1995).

> enrich a reader's or a viewer's understanding of a work. Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author's freedom of expression. For all these reasons, **the expressive element of titles requires more protection** than the labeling of ordinary commercial products.

Rogers, 875 F.2d at 998 (emphasis added). The *Rogers* test properly distinguishes between expressive (non-commercial) and commercial titles. If a title has any artistic relevance, then its expressive element is paramount, *i.e.*, it is non-commercial speech, and it should not be subject to regulation under the Trademark Act. If the title has no artistic relevance, then there is no reason for treating it differently than "labeling of ordinary commercial products," and it should be subject to regulation under the Trademark Act.

The *Rogers* test for distinguishing commercial and non-commercial titles is consistent with the tests this Court has used to define commercial speech more generally. A title with artistic relevance does "more than propose a commercial transaction." *Posadas de Puerto Rico Assocs. v. Tourism Co.*, 478 U.S. 328, 340 (1986) (quoting *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976)). An artistically relevant title does not relate "solely to the economic interests of the speaker and its audience." *Central Hudson Gas & Elec. v. Public Serv. Comm'n*, 447 U.S. 557, 561 (1980).[12] The Sixth Circuit's

12. The *Rogers* test also reflects one of the key justifications this Court has given for affording lesser protection to commercial speech, namely, that commercial speech is "hardier" than other forms of speech because of the speaker's commercial incentives. *See id.* at 564 n.6 ("[C]ommercial speech, the offspring of economic self-interest, is a hardy breed of expression that is not particularly susceptible to being crushed by overbroad regulation").

opinion ignores this critical distinction. An expressive work that is inconsistent with or even "antithetical" to a celebrity's "qualities" nevertheless will do far more than propose a commercial transaction.

While the Sixth Circuit's disregard for the line between commercial and expressive speech would alone justify this Court's review, the Sixth Circuit's error runs deeper. The Sixth Circuit not only failed to apply the *Rogers* test but also black letter trademark law, reaching the astonishing conclusion that: "If, on remand, the finder of fact determines that OutKast placed the title *Rosa Parks* on a song to which it had no artistic relevance at all, then this would constitute a violation of the Lanham Act and judgment should be entered in favor of Plaintiff." 329 F.3d at 459 (Pet. App. 42a). Thus, under the lower court's view, if a jury found that the title was "antithetical" to Ms. Parks' qualities, then Ms. Parks would not have to prove "likelihood of confusion" or any of the other prerequisites for liability in an ordinary trademark case.

The result is that artistic speech about celebrities is placed in an even less protected position than ordinary commercial speech. It bears repeating: the lower court would deny Defendants' music and other artistic speech the protection available under black letter law in ordinary trademark disputes, instead subjecting such works to a kind of "summary judgment" finding of Lanham Act liability should a jury conclude that such works are inconsistent with the celebrity's qualities. Just this past term, this Court found that over-extension of the Trademark Act's prohibition of false designations of origin "would create a species of mutant copyright law that limits the public's federal right to copy and to use expired copyrights." *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041, 2048 (2003) (quotation omitted). The Sixth Circuit decision would now use the Trademark Act to create a species of mutant defamation law, wholly unmoored by the Trademark Act's commercial focus.

Indeed, if the trial courts are permitted to follow the Sixth Circuit's direction, then speech invoking the name of a celebrity will be subjected to repression in a manner that violates both this Court's standard for "non-commercial" speech (which petitioners' song surely is) **and** this Court's standard for "commercial" speech (which requires a showing of likelihood of confusion). At a time when use of celebrity identity is expanding in constitutionally protected works of all kinds — while at the same time celebrity identity is mushrooming in commercial value — the Sixth Circuit leaves artists and public figures/celebrities on a certain collision course. The result will surely be less speech as artists and their publishers shrink from the burden of endless litigation.

3. The lower courts' adoption of conflicting tests for measuring Trademark Act and right of publicity claims against First Amendment standards threatens constitutionally-protected expression.

This Court historically has preserved freedom of speech from intrusion by intellectual property regimes through its interpretation of the fair use doctrine of copyright law. *See, e.g., Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (holding that the Sixth Circuit improperly analyzed fair use protection for a rap parody of the song "Pretty Woman"). Less attention has been devoted to the threats posed by trademark and state right of publicity laws, despite the trend in recent years to use trademarks and celebrity identities to communicate ideas in expressive works. Running parallel to this trend is another trend: the growing use of celebrity identity for product endorsements. Not surprisingly in light of the convergence of these two trends, trademark and right of publicity laws increasingly are being used to prevent "unlicensed" expressive works.

In response, lower courts have applied three contradictory tests to Trademark Act cases involving First Amendment concerns: (1) the "alternative avenues of communication" test; (2) the "likelihood of confusion" test; and (3) the bright line test of *any* artistic relevance, best articulated and applied in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). These tests attempt to reconcile the tension between the First Amendment and the Trademark Act, which has been frequently noted by lower courts, although it has not been addressed by this Court. *See, e.g., Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000) ("This case thus involves the tension between the protection afforded by the Lanham Act to trademark owners and the protection afforded by the First Amendment to expressive activity."); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 773 (8th Cir. 1994) ("This case involves the tension between the protection afforded by the Lanham Act to trademark owners and the competing First Amendment rights of the parodist."); *Silverman v. CBS Inc.*, 870 F.2d 40, 48 (2d Cir. 1989) ("Just as First Amendment values inform application of the idea/expression dichotomy in copyright law, in similar fashion such values have some bearing upon the extent of protection accorded a trademark proprietor against use of the mark in works of artistic expression."). Each of these three tests is summarized below:

- Alternative Avenues

The "alternative avenues" approach was applied in the Second Circuit's decision in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinemas, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979), which opined that: "Plaintiff's trademark is in the nature of a property right, and as such it need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.'" (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567

(1972)) (internal cites omitted).[13] The *Dallas Cowboys* court concluded that use of a distinctive cheerleader's uniform in a pornographic film was not protected by the First Amendment. *See id.* at 206 (noting that there were "numerous ways in which defendants may comment on 'sexuality in athletics' without infringing plaintiff's trademark."). The Eighth Circuit has adopted and continues to apply the alternative avenues approach to resolve First Amendment defenses in trademark cases. *See Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) ("[The plaintiff's] trademarks are a form of property, and [the plaintiff's] rights therein in need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.") (quoting *Tanner* and citing, *inter alia*, *Dallas Cowboys*); *American Dairy Queen Corp. v. New Line Productions, Inc.*, 35 F. Supp.2d 727, 734 (D. Minn. 1998) ("[T]he Court concludes that alternative avenues are available for expressing [the defendant's] ideas.").

The adequate alternative avenues test provides little, if any, protection for First Amendment freedoms. There will rarely be situations where a particular concept or idea can be expressed in one and only one way, and this Court has recognized that tampering with a speaker's choice of words often is akin if not tantamount to censorship. *See Cohen v. California*, 403 U.S. 15, 26 (1971) ("[W]e cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.").

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13. *See also Reddy Comms., Inc. v. Environmental Action Found., Inc.*, 199 U.S.P.Q. (BNA) 630, 634 (D. D.C. 1977) (rejecting First Amendment defense because "[t]he 'alternative avenues of communication' available to this defendant to express its dissatisfaction with the public utilities would appear infinite. . . . [W]e do not see how defendant's First Amendment rights will be severely hampered if this one arrow is removed from its quiver.").

Finally, the "alternatives avenue" test will inevitably draw courts into the very aesthetic determinations against which Justice Holmes famously cautioned: "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

The Sixth Circuit's opinion purports to reject the "alternative avenues" test, then a few pages later, argues that "Back of the Bus" would have been an appropriate title for the song because that title was "obviously relevant to the content of the song." 329 F.3d at 453 (Pet. App. 28a). Continuing to steer potential triers of fact to its preferred "alternative" title, the Sixth Circuit observes that *Back of the Bus* "would clearly be artistically relevant" under *Rogers*. *Id.* n.6 (Pet. App. 28a). A few paragraphs later, the Sixth Circuit reiterates "[t]he use of this woman's name unquestionably was a good marketing tool — *Rosa Parks* was likely to sell far more recordings than *Back of the Bus*." *Id.* at 453 (Pet. App. 29a). But, "[t]he song . . . is not titled *Back of the Bus*. It is titled *Rosa Parks*." *Id.* at 454 (Pet. App. 31a). By hammering home "Back of the Bus" as an alternative title, the Sixth Circuit sends a confusing message to trial courts as to the permissibility of "alternative avenues" considerations, thereby leaving juries to weigh the availability of alternative titles consistent with the "qualities" of the public figure.

- Likelihood of Confusion Test

An expressive use of a trademark will, in many instances, be unlikely to cause confusion with the owner of a trademark. Indeed, the District Court in this case held that separate and apart from First Amendment considerations, the defendants'

use of "Rosa Parks" as the title of a song on their *Aquemini* album was unlikely to cause confusion. 76 F. Supp.2d at 783-84. Because the expressive qualities of a First Amendment-protected work may reduce confusion, some courts have mistakenly drawn the conclusion that simple application of the likelihood of confusion test sufficiently protects freedom of expression. *See, e.g., Dr. Seuss Enters. v. Penguin Books USA*, 109 F.3d 1394, 1405 (9th Cir. 1997):

> In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of parody [protected by the First Amendment] is not really a separate 'defense' as such, but merely a way of phrasing the traditional response that customers are not likely to be confused as to the source, sponsorship or approval.

A variant of this approach is to apply the likelihood of confusion test, but to impose the nebulous and frequently meaningless requirement that the finding of likely confusion must be "particularly compelling" in a case involving First Amendment "interests." *See Westchester Media*, 214 F.3d at 664-65.

It is submitted, however, that the standards that protect the public from confusion in conventional trademark disputes are insufficiently robust to protect freedom of expression:

> Our likelihood of confusion test generally strikes a comfortable balance between the trademark owner's property rights and the public's expressive interests. But when a trademark owner asserts a right to control how we express ourselves . . . applying the traditional test fails to account

> for the full weight of the public's interest in free expression.

Mattel, 296 F.3d at 900.[14] Inevitably, litigation over the many factors[15] conventionally applied to assess "likelihood of confusion" will fall far short of providing the "breathing space" that speech requires. For example, in *Dr. Suess Enterprises*, the evidence concerning the likelihood of confusion factors was "indeterminate," 109 F.3d at 1406, and yet this was enough to affirm a preliminary injunction entered against an expressive work. The Ninth Circuit even invoked the rule that "[i]n a close case amounting to a tie, doubts are resolved in favor of the senior user." *Id.* at 1404 n.14. *Dr. Suess* illustrates that under the likelihood of confusion approach an indeterminate record on eight or more fact-intensive marketplace factors can be enough to support an injunction barring protected speech.

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14. *See also* Robert C. Denicola, *Trademarks As Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 192 ("As is the case with the confusion rationale, the theories contain internal restrictions that may forestall impermissible expansions of the trademark monopoly, but the limitations are subtle and incomplete; in some instances only direct appeal to constitutional principles can adequately safeguard free speech interests.").

15. The Circuit Courts of Appeal have variously formulated the likelihood of confusion test, but in each, evaluating likelihood of confusion requires examination of numerous "factors," such as the similarity of the marks, similarity of the goods and services, overlaps in the parties' respective channels of trade, the degree of care that prospective purchasers of the goods and services can be expected to exercise, the presence or absence of actual confusion, the intent of the junior user, etc. *See generally* RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 21-23 (1995).

A requirement that a finding of likely confusion be "particularly compelling" does not cure the constitutional ill. In most instances, such an inquiry will simply echo a court's initial conclusion concerning likelihood of confusion. For example, in *Westchester Media*, the court's finding of likely confusion was followed by a single terse paragraph that its finding was "particularly compelling." 214 F.3d at 667-68. Moreover, the likelihood of confusion test ordinarily requires significant litigation; the "particularly compelling" gloss will not enable cases involving artistic expression to be disposed of at any earlier stage in litigation. Finally, the test is highly subjective, and therefore does not provide artists with any guidance concerning the permissibility of their uses of celebrity names.

- Bright Line Test of No Artistic Relevance

In *Rogers v. Grimaldi*, the Second Circuit adopted and applied a clear test for assessing trademark law claims that threaten First Amendment expression. Such claims were barred unless the title has "**no** artistic relevance to the underlying work **whatsoever**, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work." *Id.* at 999 (emphasis added). As such, the *Rogers* test avoids the inevitable aesthetic judgments that accompany the "alternative avenues" approach; at the same time, it provides the clarity absent when the "likelihood of confusion" test is applied to protected speech. Indeed, *Rogers* illustrates how the appropriate legal test avoids the pitfalls of the Sixth Circuit's opinion. Thus, *Rogers* did not ask whether the title "Ginger and Fred" was consonant with the "qualities" for which Ginger Rogers was known. Rather, the *Rogers* court examined the work and the title, found that the minimal threshold of any artistic relevance was present, and affirmed summary judgment granted in the defendants' favor.

- Intracircuit Conflict Concerning the Appropriate Test

Not only are there three competing approaches among the circuits; in several circuits there are panel decisions which are extraordinarily difficult to reconcile with one another. In the Second Circuit, *Rogers*, as noted, rejected the "alternative avenues" approach earlier adopted in *Dallas Cowboys*. Later Second Circuit precedent, however, has given way to a "likelihood of confusion" approach amplified only by the nebulous requirement that the finding of confusion be "particularly compelling." *See, e.g.*, *Twin Peaks*, 996 F.2d at 1379 ("[T]he finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*."). Moreover, in the Ninth Circuit, the *Mattel* opinion adopting *Rogers* is in serious tension with *Dr. Suess*, in which First Amendment interests were given extremely short shrift under a "likelihood of confusion" type approach.

Lastly, there is palpable tension in the Sixth Circuit itself, where a painter recently was allowed to use a sports figure's entire image and likeness as the very centerpiece and foundation of his artwork — because the art was related to the athlete's accomplishments — yet Petitioners were not allowed to use a public figure's name as the title of one song on a fifteen-track album, even though their music was obviously linked to the most notable event in that public figure's life. The results and reasoning of *ETW Corp. v. Jireh Publ'g*, 332 F.3d 915 (6th Cir. 2003) and this case are irreconcilable.

- Summary

The tension between the First Amendment and trademark law has engendered deep divisions both across and within the judicial circuits. Ambiguity in the standard for First Amendment protection will inevitably lead artists and others

to avoid legal exposure by censoring themselves. Differences among the circuits may invite powerful celebrities to forum shop in their efforts to suppress speech that is unhelpful to the commercial licensing of their identities. This Court should provide uniform constitutional safeguards for expressive works that are increasingly being attacked under trademark and right of publicity theories.

CONCLUSION

As *Rogers* reminds us, "The subtleties of a title can enrich . . . understanding." 875 F.2d at 998. That is one reason for insisting on a constitutional bright line; for it is only such a standard that guarantees the breathing space creative speech requires. The Sixth Circuit constricts that space, subjecting artistic works that controversially use celebrity names to a scrutiny that few writers will willingly endure. Because of the opinion's impermissible chilling effect on speech, Petitioners respectfully urge review by this Court.

Respectfully submitted,

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APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT DATED MAY 12, 2003

UNITED STATES COURT OF APPEALS, SIXTH CIRCUIT.

No. 99-2495.

ROSA PARKS,

Plaintiff-Appellant,

v.

LAFACE RECORDS, et al.,

Defendants-Appellees.

Argued: May 4, 2001.

Decided and Filed: May 12, 2003.

Rehearing and Rehearing En Banc Denied: July 2, 2003.

Before NORRIS and COLE, Circuit Judges; HOLSCHUH, District Judge.*

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* The Honorable John D. Holschuh, United States District Judge for the Southern District of Ohio, sitting by designation.

Appendix A

OPINION

HOLSCHUH, District Judge.

This is a dispute over the name of a song. Rosa Parks is a civil rights icon who first gained prominence during the Montgomery, Alabama bus boycott in 1955. She brings suit against LaFace Records, a record producer, and OutKast, a "rap" (or "hip-hop") music duo, as well as several other named affiliates, for using her name as the title of their song, *Rosa Parks*. Parks contends that Defendants' use of her name constitutes false advertising under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and intrudes on her common law right of publicity under Michigan state law. Defendants argue that they are entitled to summary judgment because Parks has failed to show any violation of the Lanham Act or her right of publicity. Defendants further argue that, even if she has shown such a violation, their First Amendment freedom of artistic expression should be a defense as a matter of law to each of these claims. Parks also contends that Defendants' conduct renders them liable under Michigan law for defamation and tortious interference with a business relationship; Defendants have also denied liability with respect to these claims.

Parks brought this action in a Michigan state court. Defendants subsequently removed the case to the District Court for the Eastern District of Michigan. Following cross-motions for summary judgment, the district court denied Parks' motion for summary judgment and granted summary judgment for Defendants. Parks now appeals the grant of summary judgment for Defendants.

Appendix A

For the reasons hereafter set forth, we believe that, with respect to Rosa Parks' claims under the Lanham Act and under the common law right of publicity, "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). We therefore conclude that the district court erred in granting Defendants' motion for summary judgment on those claims. We conclude, however, that the district court properly granted summary judgment in favor of Defendants on Rosa Parks' state law claims of defamation and tortious interference with a business relationship.

I. BACKGROUND

A. Facts

Rosa Parks is an historical figure who first gained prominence as a symbol of the civil rights movement in the United States during the 1950's and 1960's. In 1955, while riding in the front of a segregated bus in Montgomery, Alabama, she refused to yield her seat to a white passenger and move to the back of the bus as blacks were required to do by the then-existing laws requiring segregation of the races. A 381-day bus boycott in Montgomery flowed from that one event, which eventually became a catalyst for organized boycotts, sit-ins, and demonstrations all across the South. Her single act of defiance has garnered her numerous public accolades and awards, and she has used that celebrity status to promote various civil and human rights causes as well as television programs and books inspired by her life story. She has also approved a collection of gospel recordings

by various artists entitled *Verity Records Presents: A Tribute to Mrs. Rosa Parks* (the "*Tribute*" album), released in 1995.

Defendants are OutKast, comprised of recording artists André "Dré" Benjamin and Antwan "Big Boi" Patton; their record producers, LaFace, founded by and named after Antonio "L.A." Reid and Kenny "Babyface" Edmonds;[1] and LaFace's record distributors, Arista Records and BMG Entertainment (collectively "Defendants"). In September 1998, Defendants released the album *Aquemini.* The album's first single release was a song titled *Rosa Parks*, described as a "hit single" by a sticker on the album. The same sticker that contained the name *Rosa Parks* also contained a Parental Advisory warning of "explicit content." J.A. at 60. Because, as later discussed, the critical issue in this case is a determination of the artistic relevance of the title, *Rosa Parks*, to the content of the song, the lyrics obviously must be considered in their entirety. They are as follows:

(Hook)

Ah ha, hush that fuss

Everybody move to the back of the bus

Do you wanna bump and slump with us

We the type of people make the club get crunk

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1. Parks did not effect service of process of this lawsuit on Reid or Edmonds, and they are not defendants in their individual capacity, although they are listed as defendants in the caption on the district court's docket.

Appendix A

Verse 1: (Big Boi)

Many a day has passed, the night has gone by

But still I find the time to put that bump off in your eye

Total chaos, for these playas, thought we was absent

We takin another route to represent the Dungeon Family

Like Great Day, me and my nigga decide to take the back way

We stabbing every city then we headed to that bat cave

A-T-L, Georgia, what we do for ya

Bull doggin hoes like them Georgetown Hoyas

Boy you sounding silly, thank my Brougham aint sittin pretty

Doing doughnuts round you suckas like then circles around titties

Damn we the committee gone burn it down

But us gone bust you in the mouth with the chorus now

(Hook)

Verse 2: (André)

I met a gypsy and she hipped me to some life game

Appendix A

To stimulate then activate the left and right brain

Said baby boy you only funky as your last cut

You focus on the past your ass'll be a has what

Thats one to live by or either that one to die to

I try to just throw it at you determine your own adventure

Andre, got to her station here's my destination

She got off the bus, the conversation lingered in my head for hours

Took a shower kinda sour cause my favorite group ain't comin with it

But I'm witcha you cause you probably goin through it anyway

But anyhow when in doubt went on out and bought it

Cause I thought it would be jammin but examine all the flawsky-wawsky

Awfully, it's sad and it's costly, but that's all she wrote

And I hope I never have to float in that boat

Up shit creek it's weak is the last quote

That I want to hear when I'm goin down when all's said and done

And we got a new joe in town

When the record player get to skippin and slowin down

All yawl can say is them niggas earned that crown but until then . . .

(Hook)

(Harmonica Solo)

(Hook til fade)

J.A. at 521.

B. Procedural History

Parks sued Defendants in the Wayne County Circuit Court of Michigan alleging, *inter alia*, that Defendants' unauthorized use of her name infringes on her right to publicity, defames her character, and interferes with an ongoing business relationship. Defendants removed this case to the District Court for the Eastern District of Michigan. Parks thereafter filed an amended complaint that reiterated her state law claims and added a false advertising claim under § 43(a) of the Lanham Act.

The parties entered into a stipulation of the facts[2] ("Stipulated Facts") and filed cross-motions for summary

2. Parks alleged at oral argument that both parties did not subscribe to the Stipulated Facts. However, Parks did not raise any challenge to the Stipulated Facts in the district court. Indeed, she filed a cross motion for summary judgment and insisted that there

(Cont'd)

judgment. Applying *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir.1989), the district court concluded that the First Amendment, as a matter of law, was a defense to Parks' Lanham Act and right of publicity claims. *See Parks v. LaFace Records*, 76 F.Supp.2d 775, 780-84 (E.D.Mich. 1999). Specifically, the court found that (1) an "obvious relationship" between the content of the song and its title *Rosa Parks* renders the right of publicity inapplicable as a matter of law, *id.* at 780; (2) with respect to the Lanham Act, there was no explicit representation that the work was endorsed by Parks, *id.* at 783; (3) the prominent appearance of OutKast's name on their album cured any likelihood of consumer confusion between Plaintiff's and Defendants' albums as a matter of law, *id.* at 784; and (4) even if there were some likelihood of consumer confusion, such risk was outweighed by the First Amendment interests of the Defendants, *id.* at 783. Because, in the opinion of the district court, Parks had failed to raise any genuine issue of material fact to overcome Defendants' First Amendment defense or otherwise support her claims under the Lanham Act and her right of publicity, the district court denied Parks' motion for summary judgment and granted summary judgment for Defendants. *Id.* at 788-89. The district court also granted

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(Cont'd)
was "no issue of fact that is being disputed here." J.A. at 545. "Stipulations voluntarily entered by the parties are binding, both on the district court and on [the appellate court]." *Fed. Deposit Ins. Corp. v. St. Paul Fire & Marine Ins. Co.*, 942 F.2d 1032, 1038 (6th Cir.1991). Parks has given us no cause to question the voluntariness of the Stipulated Facts; therefore, we will not consider the challenge. *See Elkins v. Richardson-Merrell, Inc.*, 8 F.3d 1068, 1072 (6th Cir.1993) (declining to address issues raised for the first time on appeal absent "exceptional circumstances").

summary judgment in favor of Defendants on Rosa Parks' claims of defamation and tortious interference with a business relationship. This appeal followed.

II. DISCUSSION

A. Standard of Review

We review the district court's grant of summary judgment *de novo*. *See Sperle v. Michigan Dep't of Corr.*, 297 F.3d 483, 490 (6th Cir.2002). Summary judgment is proper where no genuine issue of material fact exists and the moving party is entitled to judgment as a matter of law. *See* Fed.R.Civ. P. 56(c). A genuine issue of material fact exists "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). In considering such a motion, the court must view the evidence and draw all reasonable inferences in favor of the nonmoving party. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986). The central issue is "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law." *Anderson*, 477 U.S. at 251-52, 106 S.Ct. 2505.

The fact that the parties have filed cross-motions for summary judgment does not mean, of course, that summary judgment for one side or the other is necessarily appropriate. "When parties file cross-motions for summary judgment, 'the making of such inherently contradictory claims does not

constitute an agreement that if one is rejected the other is necessarily justified or that the losing party waives judicial consideration and determination whether genuine issues of material fact exist.'" *B.F. Goodrich Co. v. United States Filter Corp.*, 245 F.3d 587, 593 (6th Cir.2001) (*citing* 10A Charles Alan Wright, Arthur R. Miller and Mary Kay Kane, *Federal Practice and Procedure* § 2720 (3d ed.1998)).

B. The Lanham Act

Section 43(a) of the Lanham Act creates a civil cause of action against any person who identifies his or her product in such a way as to likely cause confusion among consumers or to cause consumers to make a mistake or to deceive consumers as to association of the producer of the product with another person or regarding the origin of the product or the sponsorship or approval of the product by another person. The language of § 43(a) is broad. It provides:

> (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
>
> > (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her

> goods, services, or commercial activities by another person . . .
>
> shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a).

Plaintiffs often invoke § 43(a) to protect intellectual property rights in "marks," or brand names, of ordinary merchandise, such as apparel, *see, e.g., A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 206 (3d Cir.2000) (suit by manufacturer of "Miraclesuit" swimwear against manufacturer of "The Miracle Bra" swimwear), or of services, such as mortgage companies, *see Platinum Home Mortgage Corp. v. Platinum Fin. Group, Inc.*, 149 F.3d 722, 725 (7th Cir.1998) (suit between mortgage service companies using the "Platinum" name).

However, the scope of § 43(a) extends beyond disputes between producers of commercial products and their competitors. It also permits celebrities to vindicate property rights in their identities against allegedly misleading commercial use by others. *See Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir.1992) (celebrity suit against snack manufacturer for unauthorized use of his distinctive voice in a commercial); *Allen v. Nat'l Video, Inc.*, 610 F.Supp. 612, 624-25 (S.D.N.Y.1985) (celebrity suit against a video retailer for use of a celebrity look-alike in its advertisements); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir.2000) (actor sued toy company for creating an action

figure named after one of his movie characters); *Abdul-Jabbar v. Gen. Motors Corp.*, 85 F.3d 407, 410 (9th Cir.1996) (professional basketball player sued car manufacturer for using his birth name to sell cars). Celebrities have standing to sue under § 43(a) because they possess an economic interest in their identities akin to that of a traditional trademark holder. *See Waits*, 978 F.2d at 1110. *See also* 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 28:15 (4th ed.2002) (discussing cases).

In order to prevail on a false advertising claim under § 43(a), a celebrity must show that use of his or her name is likely to cause confusion among consumers as to the "affiliation, connection, or association" between the celebrity and the defendant's goods or services or as to the celebrity's participation in the "origin, sponsorship, or approval" of the defendant's goods or services. *See* 15 U.S.C. § 1125(a)(1)(A); *Landham*, 227 F.3d at 626; *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 812 (9th Cir.1997); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 966 (10th Cir.1996); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir.1992). Consumer confusion occurs when "consumers . . . believe that the products or services offered by the parties are affiliated in some way," *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir.1991), or "when consumers make an incorrect mental association between the involved commercial products or their producers," *Cardtoons*, 95 F.3d at 966 (*quoting San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 564, 107 S.Ct. 2971, 97 L.Ed.2d 427 (1987) (Brennan, J., dissenting)). A "likelihood" means a "probability" rather than a "possibility" of confusion.

See Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188, 193 (5th Cir.1998); *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1189 (6th Cir.1988) (finding a "clear likelihood of confusion" because it was "highly probable" that a purchaser would believe a car wax was affiliated with another manufacturer); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed.2002) (citing cases). *But cf. Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr.*, 109 F.3d 275, 284 (6th Cir.1997) (noting that a plaintiff need only show "a sufficient *potential* of confusion, not actual confusion").

Parks contends that Defendants have violated the Lanham Act because the *Rosa Parks* title misleads consumers into believing that the song is about her or that she is affiliated with the Defendants, or has sponsored or approved the *Rosa Parks* song and the *Aquemini* album. She argues that the risk of confusion is enhanced by the fact that her authorized *Tribute* album is in the marketplace alongside Defendants' album featuring the *Rosa Parks* single. As additional evidence for her claim, Parks points to Defendants' concession that they have used the *Rosa Parks* title to advertise and promote both the song and the *Aquemini* album. She also supplies twenty-one affidavits from consumers affirming that they either believed Defendants' song was about Parks or was connected to the *Tribute* album authorized by her.

Defendants respond that Parks' Lanham Act claim must fail for two reasons. First, they claim that Parks does not possess a trademark right in her name and Defendants have not made a trademark use of her name, as allegedly required for a cause of action under the Lanham Act. Second, they

contend that even if use of the title posed some risk of consumer confusion, the risk is outweighed by Defendants' First Amendment right to free expression.

1. *Trademark Right In and Trademark Use of Parks' Name*

Citing *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Productions*, 134 F.3d 749, 756 (6th Cir.1998), Defendants contend that Parks' § 43(a) claim must fail because they have made no trademark use of her name. However, Defendants misconceive the legal basis of a Lanham Act claim. It is not necessary for them to make a "trademark" use of Rosa Parks' name in order for her to have a cause of action for false advertising under § 43(a) of the Lanham Act.

Rosa Parks clearly has a property interest in her name akin to that of a person holding a trademark. It is beyond question that Parks is a celebrity.[3] The parties have stipulated to her international fame and to her prior authorization of television programs and books. We have already established, *supra*, that courts routinely recognize a property right in celebrity identity akin to that of a trademark holder under § 43(a). *See, e.g., Landham*, 227 F.3d at 626; *Waits*, 978 F.2d at 1110; *Allen*, 610 F.Supp. at 624-25. We find Parks' prior commercial activities and international recognition as a

3. A celebrity is defined as "a celebrated or widely known person: one popularly honored for some signal achievement." *Webster's Third New International Dictionary* 359 (Phillip Babcock Gove, ed.1976).

symbol of the civil rights movement endow her with a trademark interest in her name the same as if she were a famous actor or musician.

Therefore, even though Rosa Parks' name might not be eligible for registration as a trademark, and even though Defendants were not selling Rosa Parks-brand CD's, a viable cause of action also exists under § 43(a) if consumers falsely believed that Rosa Parks had sponsored or approved the song, or was somehow affiliated with the song or the album. We turn then to Defendants' second argument, that even if Parks could establish some likelihood of confusion, the First Amendment protects Defendants' choice of title.

2. *The First Amendment Defense— Three Approaches*

Defendants allege that even if Parks' evidence demonstrates some likelihood of consumer confusion regarding their song and album, their First Amendment right of artistic expression trumps that concern. Defendants make an arguable point. From ancient times, music has been a means by which people express ideas. As such, music is firmly ensconced within the protections of the First Amendment. *See Hurley v. Irish-American Gay, Lesbian & Bisexual Group of Boston*, 515 U.S. 557, 569, 115 S.Ct. 2338, 132 L.Ed.2d 487 (1995) (stating that paintings, music and poetry are "unquestionably shielded" by the First Amendment); *Ward v. Rock Against Racism*, 491 U.S. 781, 790, 109 S.Ct. 2746, 105 L.Ed.2d 661 (1989) ("Music, as a form of expression and communication, is protected under the First Amendment."). However, the First Amendment

cannot permit anyone who cries "artist" to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be. As the Second Circuit sagely observed, "[t]he purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source [or endorsement] of the product." *Rogers*, 875 F.2d at 997; *see also Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 493 (2d Cir.1989) ("Trademark protection is not lost simply because the allegedly infringing use is in connection with a work of artistic expression." (citation omitted)). Courts have adopted three approaches to balance First Amendment interests with the protections of the Lanham Act: (a) the "likelihood of confusion" test; (b) the "alternative avenues" test; and (c) the *Rogers v. Grimaldi* test. We will examine each one in turn.

a. Likelihood of Confusion Factors Used In Commercial Trademark Cases

One approach is to rely solely on the "likelihood of confusion" factors applied in other, more traditional, trademark cases. That is, we analyze: 1) the strength of the plaintiff's mark; 2) the relatedness of the goods; 3) the similarity of the marks; 4) evidence of actual confusion; 5) the marketing channels used; 6) the likely degree of purchaser care; 7) the defendant's intent in selecting the mark; and 8) the likelihood of expansion in the product lines of the parties. *See Frisch's Rests., Inc. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir.1982) (adopting the test from *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir.1979)); *see also Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.1961) (creating a variant

of the test). Based upon that evidence, we then decide if the plaintiff has raised a genuine issue of material fact as to the likelihood of consumer confusion. Under this approach, we do not pay special solicitude to an asserted First Amendment defense.

This approach has been inferred from the Ninth Circuit case, *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir.1997). See Films of Distinction, Inc. v. Allegro Film Prods., Inc.*, 12 F.Supp.2d 1068, 1078 (C.D.Cal.1998) ("[I]t appears the Ninth Circuit will not adopt [a] .... test balancing trademark protections against the artistic interest in protecting literary titles .... *Dr. Seuss* strongly suggests that this 'balancing' has already been adequately accomplished by the statutory framework [of the Lanham Act]."). *But see Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir.2002), *cert. denied*, __ U.S. __, 123 S.Ct. 993, 154 L.Ed.2d 912 (2003) (distinguishing *Dr. Seuss*). The Tenth Circuit has obliquely endorsed this approach as well. *See Cardtoons*, 95 F.3d at 970 (suggesting the "likelihood of confusion" test "serve[s] to avoid First Amendment concerns" in trademark cases).

b. Alternative Avenues Test

A second approach is the "alternative avenues" test. This is the test urged upon us by Parks, and endorsed by a panel of the Eighth Circuit. Under the "alternative avenues" test, a title of an expressive work will not be protected from a false advertising claim if there are sufficient alternative means for an artist to convey his or her idea. *See Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir.1987) (creator

of parody tee-shirts not protected by First Amendment because he could still produce parody editorials in books, magazines, or film); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F.Supp.2d 727, 734 (D.Minn.1998) (no First Amendment protection for an infringing movie title because there were other titles the producers could use); *cf. Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 776 (8th Cir.1994) (First Amendment protection not available to parodist because the confusing trademark use was "wholly unnecessary" to the parodist's stated purpose).

c. Rogers v. Grimaldi Test

Finally, a third approach is the one developed by the Second Circuit in *Rogers v. Grimaldi* and adopted by the district court in this case. Under *Rogers*, a title will be protected unless it has "no artistic relevance" to the underlying work or, if there is artistic relevance, the title "explicitly misleads as to the source or the content of the work." *Rogers*, 875 F.2d at 999. This test was explicitly adopted by the Fifth Circuit in *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir.2000), and by a panel of the Ninth Circuit in *Mattel*, 296 F.3d at 902. It was also adopted by a district court in the Third Circuit in *Seale v. Gramercy Pictures*, 949 F.Supp. 331, 339 (1996).

d. Analysis

We conclude that neither the first nor the second approach accords adequate weight to the First Amendment interests in this case. The first approach—unmodified application of the likelihood of confusion factors in

trademark cases—gives no weight to First Amendment concerns. Instead, it treats the name of an artistic work as if it were no different from the name of an ordinary commercial product. However, this approach ignores the fact that the artistic work is *not* simply a commercial product but is also a means of communication. *See Hicks v. Casablanca Records*, 464 F.Supp. 426, 430 (S.D.N.Y.1978) ("[M]ore so than posters, bubble gum cards, or some other such 'merchandise', books and movies are vehicles through which ideas and opinions are disseminated and, as such, have enjoyed certain constitutional protections, not generally accorded 'merchandise.' "); *see also Cardtoons*, 95 F.3d at 970 ("The fact that expressive materials are sold neither renders the speech unprotected, nor alters the level of protection under the First Amendment.") (citations omitted). The names artists bestow on their art can be part and parcel of the artistic message. *See Rogers*, 875 F.2d at 998 ("Film-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works."). The fact that Defendants use the *Rosa Parks* title in advertising does not automatically erase the expressive function of the title and render it mere commercial exploitation; if a song is sold, and the title is protected by the First Amendment, the title naturally will be "inextricably intertwined" with the song's commercial promotion. *See id.*; *see also Riley v. Nat'l Fed'n of the Blind, Inc.*, 487 U.S. 781, 796, 108 S.Ct. 2667, 101 L.Ed.2d 669 (1988) (holding that when protected speech is inextricable from unprotected speech, the court will treat the entire message as protected); *Cardtoons*, 95 F.3d at 970.

The public has at least as much interest in the free exchange of ideas as it does in avoiding misleading

advertising. If Parks possesses a right to police the use of her name, even when that right can be exercised only to prevent consumer confusion, she has the means to restrict the public discourse to some extent. As Judge Kozinski has pointed out, "Intellectual property rights aren't free: They're imposed at the expense of future creators and of the public at large." *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1516 (9th Cir.1993) (Kozinski, J., dissenting from denial of rehearing en banc). "Intellectual property . . . includes the words, images, and sounds that we use to communicate, and 'we cannot indulge in the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.' " *Cardtoons*, 95 F.3d at 971 (*quoting Cohen v. California*, 403 U.S. 15, 26, 91 S.Ct. 1780, 29 L.Ed.2d 284 (1971)). In sum, we do not find the unmodified likelihood of confusion test applied to commercial products adequate to differentiate between those artists who choose titles for the purpose of legitimate artistic relevancy and those artists who choose misleading titles for the purpose of commercial gain. *See Mattel*, 296 F.3d at 900 ("[W]hen a trademark owner asserts a right to control how we express ourselves . . . applying the traditional [likelihood of confusion] test fails to account for the full weight of the public's interest in free expression."). Therefore, we reject the first approach.

The second approach, the "alternative avenues" test, is similarly problematic. The "alternative avenues" test was articulated in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir.1979), and is derived from real property law. The test is premised on the notion that, just as a real property owner may exclude a speaker

from a shopping mall so long as other locations exist for the speaker to deliver his message, a celebrity may prohibit use of his or her name so long as alternative ways exist for the artist to communicate his or her idea. *See id.* (*citing Lloyd Corp. v. Tanner*, 407 U.S. 551, 567, 92 S.Ct. 2219, 33 L.Ed.2d 131 (1972)). *See also Mutual of Omaha Ins. Co.*, 836 F.2d at 402 (*citing Dallas Cowboys*, 604 F.2d at 206); *Am. Dairy Queen Corp.*, 35 F.Supp.2d at 734.

More than one court has noted the awkwardness of analogizing property rights in land to property rights in words or ideas. *See Westchester Media*, 214 F.3d at 672 ("[T]he reasonable alternative avenues approach bears a tenuous relation to communicative and property interests embodied in trademarks."); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir.1987) ("The first amendment issues involved in this case cannot be disposed of by equating the rights of a trademark owner with the rights of an owner of real property."). Furthermore, the Second Circuit all but retracted its *Dallas Cowboys* decision in *Rogers*. *See* 875 F.2d at 999 n. 4 ("We do not read *Dallas Cowboys Cheerleaders* as generally precluding all consideration of First Amendment concerns whenever an allegedly infringing author has 'alternative avenues of communication.' ").

To suggest that other words can be used as well to express an author's or composer's message is not a proper test for weighing First Amendment rights. As Mark Twain observed, "The difference between the almost-right word and the right word is really a large matter—it's the difference between the 'lightning-bug' and the 'lightning.' " J. Bartlett, *Familiar Quotations* 527 (16th ed.1992); *see also New Kids on the*

Block v. News Am. Publ'g, Inc., 971 F.2d 302, 306 (9th Cir.1992) ("[W]e need not belabor the point that some words, phrases or symbols better convey their intended meanings than others."). Finally, adopting the "alternative avenues" test would needlessly entangle courts in the process of titling works of art; courts would be asked to determine not just whether a title is reasonably "artistic" but whether a title is "necessary" to communicate the idea. We therefore reject the alternative avenues test.

The third approach, the *Rogers* test, was adopted by the district court in this case and has been endorsed by panels in the Second, Fifth, and Ninth Circuits. Although the *Rogers* test has been criticized, *see, e.g.*, 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 10:31 (4th ed. 2002), we find it the most appropriate method to balance the public interest in avoiding consumer confusion with the public interest in free expression.

In *Rogers*, the plaintiff was dancer and film star Ginger Rogers. Italian movie maker Federico Fellini made a fictional movie titled *Ginger and Fred* about the reunion of two erstwhile cabaret dancers who became known to their fans as Fred and Ginger because they imitated Fred Astaire and Ginger Rogers in their act. *Rogers*, 875 F.2d at 996-97. Rogers' complaint alleged, *inter alia*, that the title misled viewers into thinking that the movie was about her famous collaboration with Fred Astaire, in violation of the Lanham Act, and that the use of her name infringed her right of publicity. *See id.* at 997. The *Rogers* court, finding that overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values and that the

"alternative avenues" test is insufficient to accommodate the public's interest in free expression, adopted a two-pronged test:

> In the context of allegedly misleading titles using a celebrity's name, that balance [between avoiding consumer confusion and protecting free expression] will normally not support application of the Act unless [1] the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [2] the title explicitly misleads as to the source or the content of the work.

Id. at 999.

Courts in the Second Circuit have routinely applied the *Rogers* test to other Lanham Act cases. *See Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir.1993); *Cliffs Notes*, 886 F.2d at 494; *DeClemente v. Columbia Pictures Indus., Inc.*, 860 F.Supp. 30, 51 (E.D.N.Y.1994); *Girl Scouts of U.S. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 808 F.Supp. 1112, 1119-20 (S.D.N.Y.1992). The Fifth Circuit has followed suit. *See Westchester Media*, 214 F.3d at 664.

In addition, a panel of the Ninth Circuit recently adopted the *Rogers* test in *Mattel, Inc. v. MCA Records, Inc.* In *Mattel*, the manufacturer of the well-known "Barbie" doll, sued a Danish band, Aqua, for their song *Barbie Girl*, which, among other things, contained lines that portrayed Barbie in a

negative light.[4] Mattel alleged that Aqua's use of the name "Barbie" in the title had confused consumers into believing that Mattel was affiliated with the song. *Mattel*, 296 F.3d at 899. Mattel argued that the song was not about "Barbie" and hence could not be protected by the First Amendment. In the district court, as support, Mattel introduced statements by Aqua band members in interviews that "[t]he song isn't about the doll. We're making fun of the glamourous life." *Mattel, Inc. v. MCA Records, Inc.*, 28 F.Supp.2d 1120, 1138 (C.D.Cal.1998). Mattel also supplied evidence that purported to show that individuals were misled into believing Mattel and the song were affiliated in some way. Among the evidence was a survey of 556 persons of various ages in six states, 17% of whom believed that Mattel or "Barbie" was the source of, connected with, or gave permission for the *Barbie Girl* song. *Id.* at 1132-33.

On appeal from a summary judgment in favor of the defendant, the Ninth Circuit, applying *Rogers*, concluded that the First Amendment outweighed any risk of confusion between Mattel and the song title. Specifically it found:

> Under the first prong of *Rogers*, the use of Barbie in the song title clearly is relevant to the underlying work, namely, the song itself. . . . [T]he song is about Barbie and the values Aqua claims

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4. Among the lines in the song were the following: "I'm a Barbie girl, in my Barbie world/ Life in plastic it's fantastic/ You can brush my hair, undress me everywhere . . . ," and in the chorus, "I'm a blonde bimbo girl, in a fantasy world/ Dress me up, make it tight, I'm your dolly/ . . . Kiss me here, touch me there, hanky-panky. . . ." *Mattel*, 296 F.3d at 909.

> she represents. The song title does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel. The *only* indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity.

Mattel, 296 F.3d at 902.

The application of *Rogers* in *Mattel*, as well as in cases decided in other circuits, persuades us that *Rogers* is the best test for balancing Defendants' and the public's interest in free expression under the First Amendment against Parks' and the public's interest in enforcement of the Lanham Act. We thus apply the *Rogers* test to the facts before us.

3. *Application of the Rogers Test*

a. Artistic Relevance Prong

The first prong of *Rogers* requires a determination of whether there is any artistic relationship between the title and the underlying work. *Rogers*, 875 F.2d at 999. Parks contends that a cursory review of the *Rosa Parks* title and the lyrics demonstrates that there is no artistic connection between them. Parks also submits two articles in which members of OutKast are purported to have admitted that the song was not about her. As further evidence, she offers a "translation" of the lyrics of the song *Rosa Parks*, derived from various electronic "dictionaries" of the "rap" vernacular

to demonstrate that the song truly has nothing to do with Parks herself. The "translation" of the chorus reads as follows:

> "Be quiet and stop the commotion. OutKast is coming back out [with new music] so all other MCs [mic checkers, rappers, Master of Ceremonies] step aside. Do you want to ride and hang out with us? OutKast is the type of group to make the clubs get hyped-up/excited."

Pl. Br. at 5.

Defendants respond that their use of Parks' name is "metaphorical" or "symbolic." They argue that the historical association between Rosa Parks and the phrase "move to the back of the bus" is beyond dispute and that Parks' argument that the song is not "about" her in a biographical sense is simply irrelevant.

The district court was of the opinion that the artistic relationship between the title and the song was "so obvious that the matter is not open to reasonable debate." *Parks*, 76 F.Supp.2d at 782. The court said:

> Rosa Parks is universally known for and commonly associated with her refusal . . . to . . . "move to the back of the bus." The song at issue makes unmistakable reference to that symbolic act a total of ten times. Admittedly, the song is not about plaintiff in a strictly biographical sense, but it need not be. Rather, defendants' use of

> plaintiff's name, along with the phrase "move to the back of the bus," is metaphorical and symbolic.

Id. at 780.

Contrary to the opinion of the district court, we believe that the artistic relationship between the title and the content of the song is certainly not obvious and, indeed, is "open to reasonable debate" for the following reasons.

It is true that the phrase "move to the back of the bus" is repeatedly used in the "hook" or chorus of the song. When the phrase is considered *in the context of the lyrics*, however, the phrase has absolutely nothing to do with Rosa Parks. There could be no stronger, no more compelling, evidence of this fact than the admission of "Dré" (André "Dré" Benjamin) that, "We (OutKast) never intended for the song to be about Rosa Parks or the civil rights movement. It was just symbolic, meaning that we comin' back out, so all you other MCs move to the back of the bus." J.A. at 333.[5] The composers did *not* intend it to be about Rosa Parks, and the lyrics are *not* about Rosa Parks. The lyrics' sole message is that OutKast's competitors are of lesser quality and, therefore, must "move to the back of the bus," or in other words, "take a back seat." We believe that reasonable persons could conclude that there is no relationship of any kind between Rosa Parks' name and the content of the song—a song that is nothing more and nothing less than a paean

5. According to the YZ's Unofficial Rap Dictionary, "MC" is "Master of Ceremonies, the mic checker. 'I'm the real emcee, mac daddy.'" J.A. at 493.

announcing the triumph of superior people in the entertainment business over inferior people in that business. *Back of the Bus*, for example, would be a title that is obviously relevant to the content of the song, but it also would not have the marketing power of an icon of the civil rights movement.[6] Choosing Rosa Parks' name as the title to the song unquestionably enhanced the song's potential sale to the consuming public.

The *Rogers* court made an important point which clearly applies in this case. The court said, "[p]oetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product." *Rogers*, 875 F.2d at 997. The same is also true regarding the content of a song. The purchaser of a song titled *Rosa Parks* has a right not to be misled regarding the content of that song. While the expressive element of titles admittedly requires more protection than the labeling of ordinary commercial products, "[a] misleading title with no artistic relevance cannot be sufficiently justified by a free expression interest," *id.* at 999, and the use of such a title, as in the present case, could be found to constitute a violation of the Lanham Act. Including the phrase "move to the back of the bus" in the lyrics of this song, in our opinion, does not justify, as a matter of law, the appropriation of Rosa Parks' name for the title to the song, and the fact that the phrase is repeated ten times or fifty times does not affect the question of the relevancy of the title to the lyrics.

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6. Suggesting that "Back of the Bus" would have been an appropriate title is not meant to be an application of the "alternative avenues" test discussed *supra*. It simply shows that such a title would clearly be artistically relevant under the first prong of *Rogers*.

Appendix A

The district court made the following correct observation:

> Plaintiff Rosa Parks is a well-known public figure who has been recognized as an international symbol of freedom, humanity, dignity and strength for over 43 years. Plaintiff's notoriety arose from her heroic stance against racial inequality in the South when on December 1, 1955, in Montgomery, Alabama, she refused to give up her seat to a white passenger and move to the back of the bus. This one defiant act precipitated a 381-day bus boycott that ended segregation on public transportation and ultimately sparked the Civil Rights Movement of the 1960's.

Parks, 76 F.Supp.2d at 777.

While Defendants' lyrics contain profanity and a great deal of "explicit" language (together with a parental warning), they contain absolutely nothing that could conceivably, by any stretch of the imagination, be considered, explicitly or implicitly, a reference to courage, to sacrifice, to the civil rights movement or to any other quality with which Rosa Parks is identified. If the requirement of "relevance" is to have any meaning at all, it would not be unreasonable to conclude that the title *Rosa Parks* is *not* relevant to the content of the song in question. The use of this woman's name unquestionably was a good marketing tool—*Rosa Parks* was likely to sell far more recordings than *Back of the Bus*—but its use could be found by a reasonable finder of fact to be a flagrant deception on the public regarding the actual content of this song and the creation of an impression that Rosa Parks, who had approved the use of her name in

connection with the *Tribute* album, had also approved or sponsored the use of her name on Defendants' composition.

It is certainly not dispositive that, in response to an interview following the filing of this lawsuit, one of the OutKast members said that using Rosa Parks' name was "symbolic." Where an artist proclaims that a celebrity's name is used merely as a "symbol" for the lyrics of a song, and such use is highly questionable when the lyrics are examined, a legitimate question is presented as to whether the artist's claim is sincere or merely a guise to escape liability. Our task, it seems to us, is not to accept without question whatever purpose Defendants may now claim they had in using Rosa Parks' name. It is, instead, to make a determination as to whether, applying the law of *Rogers*, there is a genuine issue of material fact regarding the question of whether the title is artistically relevant to the content of the song. As noted above, crying "artist" does not confer *carte blanche* authority to appropriate a celebrity's name. Furthermore, crying "symbol" does not change that proposition and confer authority to use a celebrity's name when none, in fact, may exist.

It appears that the district court's rendition of summary judgment for OutKast was based on the court's conclusion that Defendants' use of Plaintiff's name as the song's title was "metaphorical and symbolic." *Id.* at 780. The obvious question, however, is *symbolic of what?* There is no doubt that Rosa Parks is a symbol. As the parties agree, she is "an international symbol of freedom, humanity, dignity and strength." J.A. at 79. There is not even a hint, however, of any of these qualities in the song to which Defendants attached her name. In lyrics that are laced with profanity and

in a "hook" or chorus that is pure egomania, many reasonable people could find that this is a song that is clearly *antithetical* to the qualities identified with Rosa Parks. Furthermore, the use of Rosa Parks' name in a metaphorical sense is highly questionable. A metaphor is "a figure of speech in which a word or phrase denoting one kind of object or action is used in place of another to suggest a likeness or analogy between them." *Webster's Third New International Dictionary* 1420 (Phillip Babcock Gove, ed.1976). The use of the phrase "go to the back of the bus" may be metaphorical to the extent that it refers to OutKast's competitors being pushed aside by OutKast's return and being forced to "take a back seat." The song, however, is not titled *Back of the Bus*. It is titled *Rosa Parks*, and it is difficult to equate OutKast's feeling of superiority, metaphorically or in any other manner, to the qualities for which Rosa Parks is known around the world. We believe that reasonable people could find that the use of Rosa Parks' name as the title to this song was not justified as being metaphorical or symbolic of anything for which Rosa Parks is famous. To the contrary, reasonable people could find that the name was appropriated solely because of the vastly increased marketing power of a product bearing the name of a national heroine of the civil rights movement.

We do not mean to imply that Rosa Parks must always be displayed in a flattering manner, or that she should have the ability to prevent any other characterization of her. She is a celebrity and, as such, she cannot prevent being portrayed in a manner that may not be pleasing to her. As the court noted in *Guglielmi v. Spelling-Goldberg Productions*, 25 Cal.3d 860, 160 Cal.Rptr. 352, 603 P.2d 454, 460 (1979) (Bird J., concurring), "[t]he right of publicity derived from

public prominence does not confer a shield to ward off caricature, parody and satire." It has been held, for example, that, "[p]arodies of celebrities are an especially valuable means of expression because of the role celebrities play in modern society." *Cardtoons*, 95 F.3d at 972. The present case, however, does not involve any claim of caricature, parody or satire. It involves, instead, the use of a celebrity's name as the title to a song when it reasonably could be found that the celebrity's name has no artistic relevance to the content of the song. It involves, in short, a reasonable dispute whether the use of Rosa Parks' name was a misrepresentation and false advertising or whether it was a legitimate use of a celebrity's name in some recognized form of artistic expression protected by the First Amendment.

In *Rogers*, the court, in discussing the title to the movie *Ginger and Fred*, observed that "there is no doubt a risk that some people looking at the title 'Ginger and Fred' might think the film was about Rogers and Astaire in a direct, biographical sense. For those gaining that impression, the title is misleading." 875 F.2d at 1001. Likewise, in the present case, some people looking at the title *Rosa Parks* might think the song is about Rosa Parks and for those gaining that impression (as twenty-one consumer affidavits filed in this case indicate happened, J.A. at 342-62), the title is misleading.[7] This, standing alone, may not be sufficient to

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7. Typical of the affidavits filed in this case is that of Curt Merrweth:

> 1. I purchased the Outkast album, Aquemini, with Rosa Parks' song advertised on the outside label.
>
> (Cont'd)

show a violation of the Lanham Act *if* the title is nevertheless artistically relevant to the content of the underlying work.

There is a clear distinction, however, between the facts in *Rogers* and the facts in the present case. In *Rogers*, the court had no difficulty in finding that the title chosen for the movie *Ginger and Fred* had artistic relevance to the content of the movie. "The central characters in the film are nicknamed 'Ginger' and 'Fred,' and these names are not arbitrarily chosen just to exploit the publicity value of their real life counterparts but instead have genuine relevance to the film's story." 875 F.2d at 1001. The *Rogers* court further pointed out that the title *Ginger and Fred* is "entirely truthful as to its content in referring to the film's fictional protagonists who are known to their Italian audience as 'Ginger and Fred.'" *Id.* In other words, the title in *Rogers* was obviously relevant and truthful as to the film's content, because the film was about the main characters known in the film as Ginger and Fred. In contrast, it cannot be said that the title in the present case, *Rosa Parks*, is clearly truthful as to the content of the song which, as OutKast admits, is not about Rosa Parks at all and was never intended to be about Rosa Parks, and which does not refer to Rosa Parks or to the qualities for which she is known.

(Cont'd)

> 2. I thought the lyrics were about the civil rights movement and Mrs. Rosa Parks' historic contributions.
>
> 3. I learned after purchasing the album and listening to the content of the song that Mrs. Parks' name was used to get my attention so that I would buy the album.

J.A. at 343.

Furthermore, the contrast between the real Ginger and Fred and the fictional Ginger and Fred in the film served the director's purpose of satirizing contemporary television and, in that sense, the title was "an integral element of the film and the film maker's artistic expressions." *Id.* OutKast's only explanation for the use of Rosa Parks' name in the title of their song, however, is that the name Rosa Parks is "a symbol." It is, indeed, a symbol, but the question presented is how the symbol of Rosa Parks, a symbol of "freedom, humanity, dignity, and strength," is artistically related to the content of a song that appears to be diametrically opposed to those qualities. The song is not claimed to be a satire, a parody or some other form of artistic expression that would be protected under the broad umbrella of the First Amendment. The mere fact that the phrase "move to the back of the bus" is an apt description of OutKast's attitude toward entertainers they regard as lesser human beings is not, in our view, a justification, as a matter of law, for appropriating the name of Rosa Parks.

Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894 (9th Cir.2002) involved facts that are remarkably different from the facts of this case. In applying the first prong of *Rogers*, the Ninth Circuit in *Mattel* stated:

> We expect a title to describe the underlying work, not to identify the producer, and Barbie Girl does just that.
>
> The Barbie Girl title presages a song about Barbie, or at least a girl like Barbie. The title conveys a message to consumers about what they

> can expect to discover in the song itself; it's a quick glimpse of Aqua's take on their own song. The lyrics confirm this: The female singer, who calls herself Barbie, is "a Barbie girl, in [her] Barbie world." She tells her male counterpart (named Ken), "Life in plastic, it's fantastic. You can brush my hair, undress me everywhere/ Imagination, life is your creation." And off they go to "party." The song pokes fun at Barbie and the values that Aqua contends she represents.
>
> . . . .
>
> *Under the first prong of* Rogers, *the use of Barbie in the song title clearly is relevant to the underlying work, namely, the song itself. As noted, the song is about Barbie and the values Aqua claims she represents.*

Id. at 901-902 (emphasis added).

In sharp contrast to *Mattel*, it is highly questionable that the facts in the present case satisfy the first prong of *Rogers*. Whereas the title *Barbie Girl* was clearly relevant to the lyrics of the song, ("the song is about Barbie and the values Aqua claims she represents"), it cannot be said that the title *Rosa Parks* is clearly relevant to the lyrics of the song in this case. While the lyrics of *Barbie Girl* are certainly not flattering to the wholesome image preferred by the creator of Barbie ("the song pokes fun at Barbie and the values that Aqua contends she represents"), parody is an artistic form of expression protected by the First Amendment. In contrast, there has been

no attempt to defend *Rosa Parks* on the ground that it constitutes a parody of Rosa Parks or a satire of Rosa Parks or some other form of artistic expression involving Rosa Parks herself.

The *Mattel* case, therefore, in our view, is completely distinguishable from the facts of the present case. If anything, we believe its application of *Rogers* and the result of that application to the title and lyrics of *Barbie Girl* could support a conclusion that the title *Rosa Parks* has no artistic relevance to the lyrics of Defendants' song. The result would be that Defendants cannot satisfy even the first prong of *Rogers* in order to justify their appropriation of Rosa Parks' name.

A case that is more similar to the present case than *Mattel* is *Seale v. Gramercy Pictures*, 949 F.Supp. 331 (E.D.Pa.1996). In *Seale*, defendants produced and distributed a movie entitled "Panther," which was a combination of fiction and historical fact involving Bobby Seale and the Black Panther Party, founded by Seale and Huey P. Newton in 1966. Seale, Newton and another leader of the Black Panther Party, Eldridge Cleaver, were all portrayed in the movie by actors. Similar to the stipulation in the present case, it was undisputed that the plaintiff was "a well-known public and historical figure" and that, "[t]he Plaintiff's name and his role in the Black Panther Party may be found in most history books discussing the Civil Rights Movement of the 1960's." *Id.* at 335.

In addition to the movie, various defendants in the case produced: (1) a book titled *Panther: A Pictorial History of the Black Panthers and the Story Behind the Film*; (2) a videotape of the movie; and (3) a CD/cassette containing a collection of the songs from the movie. The promotional cover for the home

video release of the movie mentioned Seale's name and had a photograph of the actors who portrayed Seale, Newton and Cleaver in the movie. The cover of the musical CD/cassette contained the same photograph that was on the home video, together with another photograph of a scene from the movie. Seale, who had never consented to the use of his name for the movie, the book, the videotape or the CD/cassette, brought suit alleging violations of § 43(a) of the Lanham Act and his common-law right of publicity. The defendants moved for summary judgment on all claims.

The *Seale* court found that defendants were entitled to summary judgment on plaintiff's common-law right of publicity claim as it concerned the movie, the pictorial history book, and the videotape. The court had no trouble finding that the creation of a movie and history book that integrated fictitious people and events with historical people and events surrounding the emergence of the Black Panther Party in the late 1960's was protected by the First Amendment. The court also found that the "use of the Plaintiff's name and likeness on the cover of the pictorial history book and on the cover for the home video are *clearly related to the content of the book and the film*, the subject matter of which deals with the Black Panther Party and the Plaintiff's role as co-founder of the Party." *Id.* at 337 (emphasis added).

The use of the plaintiff's name and likeness on the cover of the musical CD/cassette, however, was an entirely different matter. The music contained on the CD/cassette consisted of various songs composed by different musicians. The court pointed out:

> Clearly, the use of the Plaintiff's name and likeness on the cover of the musical CD/cassette does not

> relate to the content in the CD/cassette in the same manner as the use of the Plaintiff's name and likeness on the cover of the home video and pictorial history book relates to the content of the film and pictorial history book—the subject matter of which concerns the Black Panther Party and the Plaintiff's role as co-founder of the Party. The film and pictorial history book tell the story of the Black Panther Party and the Plaintiff's role in that Party in the late 1960's; *the musical CD/cassette is merely a collection of different songs performed by different musicians, which songs have no direct connection to the Plaintiff or the history of the Black Panther Party.* There is a genuine issue of material fact, therefore, whether the use of the Plaintiff's name and likeness on the cover of the musical CD/cassette is clearly related to the content of the film "Panther" and serves as an advertisement for the film, or whether the Defendants' use of the Plaintiff's name and likeness on the cover of the CD/cassette is a disguised advertisement for the sale of the CD/cassette. *See Rogers v. Grimaldi*, 875 F.2d 994, 1004-05 (2d Cir.1989).

Id. at 337-38 (emphasis added).[8]

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8. In addition to *Rogers*, the *Seale* court also referred to Section 46 of the *Restatement (Third) of Unfair Competition*, published in 1995. That section is titled "Appropriation of the Commercial Value of a Person's Identity: The Right of Publicity." It provides, "One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for the purposes of trade is subject to liability . . ."

(Cont'd)

Appendix A

The court made the same findings in virtually the same language regarding Seale's claim under Section 43(a) of the Lanham Act, again applying *Rogers* and reaching the same result, *i.e.*, that a genuine issue of material fact was presented. *Id. at 340.* The court, therefore, denied defendants' motion for summary judgment on both the plaintiff's common law right of publicity claim and Lanham Act claim as those claims related to the defendants' use of Bobby Seale's name and likeness on the CD/cassette.[9]

We reach the same conclusion in the present case. There is a genuine issue of material fact whether the use of Rosa Parks' name as a title to the song and on the cover of the album is artistically related to the content of the song or

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(Cont'd)

The court further noted that, although Section 47 of the *Restatement (Third) of Unfair Competition* states that use "for purposes of trade" does not ordinarily include "the use of a person's identity in news reporting, commentary, entertainment, works of fiction or non-fiction, or in advertising that is incidental to such uses," comment c to that section states that "if the name or likeness is used solely to attract attention to a work that is not related to the identified person, the user may be subject to liability for a use of the other's identity in advertising." *See Seale*, 949 F.Supp. at 336.

9. The court in the *Seale* case, following a bench trial on the merits, found that the plaintiff had failed to present sufficient evidence to support his claims and entered judgment in favor of defendants. *See Seale v. Gramercy Pictures*, 964 F.Supp. 918 (E.D.Pa.1997), *aff'd*, 156 F.3d 1225 (3d Cir.1998). The significance of *Seale* in the context of the present case, however, is that the question of liability was not determined on a motion for summary judgment but was left for a trial on the merits.

whether the use of the name Rosa Parks is nothing more than a misleading advertisement for the sale of the song.

b. Misleading Prong

In *Rogers*, the court held that if the title of the work is artistically relevant to its content, there is no violation of the Lanham Act *unless* the "title explicitly misleads as to the source or the content of the work." 875 F.2d at 999. The court noted with reference to the first prong of the *Rogers* analysis:

> A misleading title with no artistic relevance cannot be sufficiently justified by a free expression interest. For example, if a film-maker placed the title "Ginger and Fred" on a film to which it had no artistic relevance at all, the arguably misleading suggestions as to source or content implicitly conveyed by the title could be found to violate the Lanham Act as to such a film.

Id.

In discussing the second prong of its analysis, in the context of using a celebrity's name in the title of some artistic work, the court explained:

> [T]itles with at least minimal artistic relevance to the work may include explicit statements about the content of the work that are seriously misleading. For example, if the characters in the film in this case had published their memoirs

> under the title "The True Life Story of Ginger and Fred," and if the film-maker had then used that fictitious book title as the title of the film, the Lanham Act could be applicable to such an explicitly misleading description of content. But many titles with a celebrity's name make no explicit statement that the work is about that person in any direct sense; the relevance of the title may be oblique and may become clear only after viewing or reading the work. As to such titles, the consumer interest in avoiding deception is too slight to warrant application of the Lanham Act. . . . Where a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work, it is not false advertising under the Lanham Act.

Id. at 1000 (footnote omitted).

We considered all the facts presented to us and concluded that, with reference to the first prong of the *Rogers* analysis, the issue of artistic relevance of the title *Rosa Parks* to the lyrics of the song is highly questionable and cannot be resolved as a matter of law. However, if, on remand, a trier of fact, after a full evidentiary hearing, concludes that the title *is* used in some symbolic or metaphorical sense, application of the *Rogers* analysis, under the particular facts of this case, would appear to be complete. In the present case, the title *Rosa Parks* "make[s] no explicit statement that the work is about that person in any direct sense." In other words, Defendants did not name the song, for example, *The True Life Story of Rosa Parks* or *Rosa Parks' Favorite Rap.*

In short, whether the title *Rosa Parks* has any artistic relevance to the content of the song is an issue that must be resolved by a finder of fact following an evidentiary hearing and not by a judge as a matter of law upon the limited record submitted in support of a motion for summary judgment. If, on remand, the finder of fact determines that OutKast placed the title *Rosa Parks* on a song to which it had no artistic relevance at all, then this would constitute a violation of the Lanham Act and judgment should be entered in favor of Plaintiff. However, if the finder of fact determines that the title is artistically relevant to the song's content, then the inquiry is at an end because the title "is not explicitly misleading as to the content of the work." In that event, judgment should be entered in favor of Defendants.

C. Right of Publicity

1. *Applicable Law*

The right of publicity protects the identity of a celebrity from exploitive commercial use. *See Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983). "The theory of the right is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity." *Id.* As such, the common law right of publicity forms a species of property right. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573, 97 S.Ct. 2849, 53 L.Ed.2d 965 (1977); *Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, 270 F.3d 298, 325 (6th Cir. 2001); *Cardtoons*, 95 F.3d at 967.

Appendix A

The right of publicity is governed by state law. *See Landham*, 227 F.3d at 622. Michigan has indicated that it would recognize a right of publicity, *see Pallas v. Crowley, Milner & Co.*, 322 Mich. 411, 33 N.W.2d 911, 914 (1948), and the parties have not questioned that Plaintiff has a right of publicity. The dispute is over its application to the facts of this case.

Parks' right of publicity argument tracks that of her Lanham Act claim. She alleges that Defendants have profited from her fame by using her name solely for a commercial purpose. She supplies much the same evidence in support of her right of publicity claim as she did for her Lanham Act claim: the lyrics of *Rosa Parks*, the "translation," and the press clippings quoting OutKast members. Defendants do not deny that they have used the title *Rosa Parks* commercially, but argue that Parks has produced no evidence that their use was *solely* commercial. Instead, they argue that the choice was also artistic, and that they therefore have a complete defense in the First Amendment.

The district court agreed with Defendants. The district court applied *Rogers*, which, in addition to the false advertising claim under § 43(a), also dealt with a right of publicity action arising under Oregon state law. Under *Rogers*, with respect to a right of publicity claim, a title that uses a celebrity's name will be protected by the First Amendment unless the title is "wholly unrelated" to the content of the work or was "simply a disguised commercial advertisement for the sale of goods or services." *Rogers*, 875 F.2d at 1004. The district court found that, as a matter of law, there was an artistic relationship between the

title and the content of the song, and therefore it could not be considered "simply a disguised commercial advertisement." *Parks*, 76 F.Supp.2d at 781. Defendants' use of the title to promote the album did not change this result. *Id.*

2. *Analysis*

A right of publicity claim is similar to a false advertising claim in that it grants a celebrity the right to protect an economic interest in his or her name. *See Carson*, 698 F.2d at 835 ("The right of publicity has developed to protect the commercial interest of celebrities in their identities."). However, a right of publicity claim does differ from a false advertising claim in one crucial respect; a right of publicity claim does not require any evidence that a consumer is likely to be confused. *See Herman Miller*, 270 F.3d at 319-20 *(citing Restatement (Third) of Unfair Competition § 46* cmt. c (1995)); *Rogers*, 875 F.2d at 1004; *Cairns v. Franklin Mint Co.*, 24 F.Supp.2d 1013, 1030 (C.D.Cal.1998). All that a plaintiff must prove in a right of publicity action is that she has a pecuniary interest in her identity, and that her identity has been commercially exploited by a defendant. *See Landham*, 227 F.3d at 624; *Carson*, 698 F.2d at 835.

The parties have stipulated that Parks is famous and that she has used her name to promote other goods and services. She has therefore established an economic interest in her name. *See Landham*, 227 F.3d at 624. Furthermore, Defendants admit that they have used Parks' name as the name of their song, and have used that name to sell the song

and their album. They argue, however, that, as with the Lanham Act claim, their First Amendment right of artistic expression should prevail over Parks' claim.

a. Cognizability of a First Amendment Defense

Because a plaintiff bears a reduced burden of persuasion to succeed in a right of publicity action, courts and commentators have recognized that publicity rights carry a greater danger of impinging on First Amendment rights than do rights associated with false advertising claims. *See Rogers*, 875 F.2d at 1004; *see also Cardtoons*, 95 F.3d at 967 (noting that publicity rights offer "substantially broader protection" than laws preventing false endorsement); *cf.* Roberta Rosenthal Kwall, *The Right of Publicity v. The First Amendment: A Property and Liability Rule Analysis*, 70 Ind. L.J. 47 (1994).

We have recognized the importance of a First Amendment defense to right of publicity actions in a recent case. In *Ruffin-Steinback v. dePasse*, friends and family members of the Motown group, the "Temptations," sued the makers of a televised mini-series for the manner in which they and the former group members were portrayed in the film. 82 F.Supp.2d 723, 726-27 (E.D.Mich.2000), *aff'd*, 267 F.3d 457 (6th Cir.2001). The plaintiffs alleged that their likenesses were appropriated to endorse a product, the film, without their permission. *Id.* at 728. The court found in that case that the plaintiffs could not overcome the defendant's First Amendment defense, even where the portrayal of the plaintiffs was partly fictionalized, and even where the likenesses of the plaintiffs were used to promote a

videocassette version of the mini-series. *Id.* at 730-31; *see also Seale*, 949 F.Supp. at 337 (holding that the film *Panther*, which used the name and likeness of Black Panther founder Bobby Seale, was protected by the First Amendment).

As with the Lanham Act, then, we must conduct another balancing of interests—Parks' property right in her own name versus the freedom of artistic expression. *See ETW Corp. v. Jireh Publ'g, Inc.*, 99 F.Supp.2d 829, 834-36 (N.D.Ohio 2000); *Pooley v. Nat'l Hole-in-One Ass'n*, 89 F.Supp.2d 1108, 1113-14 (D.Ariz.2000); *dePasse*, 82 F.Supp.2d at 731.

b. Application of a First Amendment Defense

In *Rogers*, the Second Circuit held that movie titles are protected from right of publicity actions unless the title is "wholly unrelated" to the content of the work or was "simply a disguised commercial advertisement for the sale of goods or services." 875 F.2d at 1004. This test is supported in the context of other expressive works by comment c of § 47 of the *Restatement (Third) of Unfair Competition*. It states that "[u]se of another's identity in a novel, play, or motion picture is . . . not ordinarily an infringement [of the right of publicity, unless] the name or likeness is used solely to attract attention to a work that is not related to the identified person." The *Rogers* formulation is also supported by the decision in *dePasse*. In *dePasse*, the court cited *Seale*, 949 F.Supp. at 337, for the proposition that the relationship between a plaintiff's identity and the content of the work is an element of a defense to a right of publicity action. *See dePasse*,

82 F.Supp.2d at 731. *Seale*, in turn, relied upon *Rogers*. *See* 949 F.Supp. at 337; *see also Rogers*, 875 F.2d at 1004-05. We thus apply *Rogers* to the instant case.

For the same reasons we have stated earlier and need not repeat, we believe that Parks' right of publicity claim presents a genuine issue of material fact regarding the question of whether the title to the song is or is not "wholly unrelated" to the content of the song. A reasonable finder of fact, in our opinion, upon consideration of all the evidence, could find the title to be a "disguised commercial advertisement" or adopted "solely to attract attention" to the work. *See Rogers*, 875 F.2d at 1004-05.

D. Other Michigan State Law Claims

Parks also appeals the district court's decision to grant summary judgment to Defendants on her state law claims for defamation and intentional interference with a business relationship. Finding no merit in either of these claims, we treat them briefly below.

1. *Defamation*

Parks argues that the song defames her character or places her in a false light. To succeed on a defamation claim, a public figure must prove actual malice. *See New York Times Co. v. Sullivan*, 376 U.S. 254, 279-80, 84 S.Ct. 710, 11 L.Ed.2d 686 (1964). In turn, actual malice requires a showing, by clear and convincing evidence, that a defendant made a false statement with knowledge of the falsity or with reckless disregard for the truth. *See Philadelphia Newspapers, Inc. v.*

Hepps, 475 U.S. 767, 773, 106 S.Ct. 1558, 89 L.Ed.2d 783 (1986). A statement is actionable only if it states actual facts about plaintiff that are "provable and false." *Milkovich v. Lorain Journal Co.*, 497 U.S. 1, 16-17, 19-20, 110 S.Ct. 2695, 111 L.Ed.2d 1 (1990). The song is plainly not about Parks in any biographical sense of the term, and certainly does not make any factual statements about her. As there is no factual statement about her, Parks cannot show even the first element of a defamation claim. Therefore, we find this argument meritless.

Parks' defamation-by-implication argument is likewise meritless. As with a traditional defamation claim, a plaintiff in a defamation-by-implication claim must establish a material falsity. *See Hawkins v. Mercy Health Serv., Inc.*, 230 Mich.App. 315, 583 N.W.2d 725, 731-32 (1998). Parks has not done so. The mere fact that Parks' name is attached to something "offensive" is not enough to overcome Defendants' First Amendment rights. *See Hustler Magazine v. Falwell*, 485 U.S. 46, 57, 108 S.Ct. 876, 99 L.Ed.2d 41 (1988) (applying the public figure defamation test to deny celebrity's intentional infliction of emotional distress claim against defendant's magazine for its depiction of him engaged in incest and alcohol abuse). We therefore agree that Defendants deserved summary judgment on this claim.

2. *Intentional Interference with Business Relationship*

Parks also claims that Defendants intentionally interfered with her business relationship with the producers of the *Tribute* album. To make a successful claim for tortious

interference with a business relationship in Michigan, Parks must show an "intentional doing of a per se wrongful act or the intentional doing of a lawful act with malice and unjustified in law for the purpose of invading . . . contractual rights or business relationship[s]." *Chrysler Int'l Corp. v. Cherokee Exp. Co.*, 134 F.3d 738, 745 (6th Cir.1998) (citation and internal quotation marks omitted) (applying Michigan law). This "wrongful act" must have hastened a contract breach or another breakdown of a business relationship. *See Lakeshore Cmty. Hosp., Inc., v. Perry*, 212 Mich.App. 396, 538 N.W.2d 24, 27 (1995). No such breach or breakdown occurred in this case. Parks cites dicta from *Stormor v. Johnson*, 587 F.Supp. 275 (W.D.Mich.1984), which suggests that Michigan might recognize a claim if a defendant's action made the plaintiff's business relationship more expensive or burdensome. Ignoring for the moment that Michigan has not clearly recognized a tort claim on such grounds, Parks has not brought forth evidence that Defendants' song *Rosa Parks* makes the production or promotion of the *Tribute* album more expensive or burdensome. Consequently, this claim must fail.

CONCLUSION

We are not called upon in this case to judge the quality of Defendants' song, and whether we personally regard it as repulsive trash or a work of genius is immaterial to a determination of the legal issues presented to us.[10] Justice Holmes, 100 years ago, correctly observed that, "It would be a dangerous undertaking for persons trained only to the

10. "What is food to one, is to others bitter poison." Lucretius, 99-55 B.C., John Bartlett, *Familiar Quotations*, 16th ed., p. 90.

law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *George Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251, 23 S.Ct. 298, 47 L.Ed. 460 (1903). The same is no less true today and applies with equal force to musical compositions. The point, however, is that while we, as judges, do not presume to determine the artistic quality of the song in question, we have the responsibility, as judges, to apply a legal standard of "artistic relevance" in resolving the rights of Rosa Parks concerning the use of her name and the First Amendment rights of the Defendants in the creation and marketing of a musical composition.[11] Application of that standard involves a recognition that Rosa Parks has no right to control her image by censoring disagreeable portrayals. It also involves a recognition that the First Amendment cannot permit anyone who cries "artist" to have *carte blanche* when it comes to naming and advertising his works.

In this case, for the reasons set forth above, the fact that Defendants cry "artist" and "symbol" as reasons for appropriating Rosa Parks' name for a song title does not absolve them from potential liability for, in the words of

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11. *Cf. Miller v. California*, 413 U.S. 15, 93 S.Ct. 2607, 37 L.Ed.2d 419 (1973), in which the Supreme Court, acknowledging "the inherent dangers of undertaking to regulate any form of expression," nevertheless adopted a legal standard regarding obscenity and the First Amendment which required the trier of fact to consider, *inter alia*, whether the work, taken as a whole, lacks "serious literary, artistic, political, or scientific value." *Id.* at 23-24, 93 S.Ct. 2607.

Shakespeare, filching Rosa Parks' good name.[12] The question of that liability, however, should be determined by the trier of fact after a full evidentiary hearing and not as a matter of law on a motion for summary judgment.

For the reasons stated, as to Rosa Parks' Lanham Act claim and her common law right of publicity claim, the judgment of the District Court is **REVERSED** and this case is **REMANDED** for future proceedings not inconsistent with this Opinion. With respect to Rosa Parks' claims of defamation and tortious interference with a business relationship, the judgment of the District Court is **AFFIRMED.**

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12. Who steals my purse steals trash; 'tis something, nothing;
'Twas mine, 'tis his, and has been slave to thousands;
But he that filches from me my good name
Robs me of that which not enriches him
And makes me poor indeed.

William Shakespeare, *Othello*, act 3, sc. 3.

APPENDIX B — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF MICHIGAN, SOUTHERN DIVISION, DENYING PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT AND INJUNCTIVE RELIEF AND GRANTING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT DATED NOVEMBER 18, 1999

United States District Court,
E.D. Michigan,
Southern Division.

No. 99-CV-60256-AA.

Nov. 18, 1999.

Rosa PARKS,

Plaintiff,

v.

LAFACE RECORDS, Arista Records, Inc., BMG Entertainment, Outkast, Kenny B. Edmonds, Antonio M. Reid, and agents, attorneys and John and Jane Does,

Defendants.

* * *

ORDER DENYING PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT AND INJUNCTIVE RELIEF AND GRANTING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT

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HACKETT, District Judge.

Plaintiff Rosa Parks is a well-known public figure who has been recognized as an international symbol of freedom, humanity, dignity and strength for over 43 years. Plaintiff's notoriety arose from her heroic stance against racial inequality in the South when on December 1, 1955, in Montgomery, Alabama, she refused to give up her seat to a white passenger and move to the back of the bus. This one defiant act precipitated a 381-day bus boycott that ended segregation on public transportation and ultimately sparked the Civil Rights Movement of the 1960's. The above-captioned case presents a conflict between plaintiff's right to protect her celebrated name and the First Amendment right of others to use her name in an expressive work. Specifically at issue is whether plaintiff can prevent the use of her name as the title of a rap song written, performed, marketed and distributed by defendants. Now before the court are the parties' cross-motions for summary judgment. Oral argument was heard on November 4, 1999. For the following reasons, plaintiff's motion shall be denied, and summary judgment shall be granted regrettably in defendants' favor.

I. *FACTS*

The facts relevant to disposition of this matter are few and undisputed. Defendants are entertainers and producers of popular music. Specifically, Kenny Edmonds and Antonio Reid[1] are recording artists and the members of the musical

1. Although named in the caption of plaintiff's complaint and other pleadings, Edmonds and Reid were never served with process, and, therefore, are not parties to this litigation in their individual capacities.

group Outkast, whose services are contractually rendered to LaFace Records. LaFace is a record company engaged in the business of creating, manufacturing and distributing musical sound recordings. LaFace's recordings are manufactured and distributed by a variety of entities under the auspices of Arista Records and BMG Entertainment.

During the week of September 28, 1998, defendants released Outkast's album called *Aquemini,* which included a total of 15 songs. The album's first single release was track number three, a song entitled "Rosa Parks." Plaintiff is not mentioned by name in the lyrics, and the song is not about her or the Civil Rights Movement. However, the chorus includes the words "Ah, ha, hush that fuss. Everybody move to the back of the bus," which are repeated a total of ten times over the course of the work.

The band Outkast, the album *Aquemini,* and the song "Rosa Parks" have all enjoyed a great degree of critical acclaim. *Aquemini* has sold over two million copies (double platinum status), and "Rosa Parks" has enjoyed long-lasting success on the Billboard Charts. In fact, Outkast received their first-ever Grammy nomination for the song. Consequently, defendants have advertised and promoted the *Aquemini* album, the hit single "Rosa Parks" and its Grammy nomination in ways that are customary in the music business, such as in print advertisements, in a music video, and with stickers affixed to the front of each cassette and compact disc jewel case indicating that the album contains "The Hit Singles 'Rosa Parks' And 'Skew It On The Bar-B.'"[2]

2. The sticker also states in smaller print: "Parental Advisory. Explicit Content."

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No legal relationship of any kind exists between plaintiff and defendants, and defendants did not attempt to secure plaintiff's permission to use her name prior to the release of their *Aquemini* album. Plaintiff, however, opposes defendants' use of her name without compensation. In particular, plaintiff is offended by the use of her name in association with music that contains, according to plaintiff, "profanity, racial slurs, and derogatory language directed at women." To date, defendants have continued to use plaintiff's name on and in connection with the song "Rosa Parks" and the album *Aquemini*. Accordingly, plaintiff filed this lawsuit seeking monetary and injunctive relief. The court now turns to the parties' pending motions.

II. *STANDARD OF REVIEW*

Federal Rule of Civil Procedure 56(c) empowers the court to render summary judgment "forthwith if the pleadings, depositions, answers to interrogatories and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *See F.D.I.C. v. Alexander,* 78 F.3d 1103, 1106 (6th Cir.1996). The Supreme Court has affirmed the court's use of summary judgment as an integral part of the fair and efficient administration of justice. The procedure is not a disfavored procedural shortcut. *Celotex Corp. v. Catrett,* 477 U.S. 317, 327, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986); *see also Kutrom Corp. v. City of Center Line,* 979 F.2d 1171, 1174 (6th Cir.1992).

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The standard for determining whether summary judgment is appropriate is " 'whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law.'" *Winningham v. North Am. Resources Corp.*, 42 F.3d 981, 984 (6th Cir.1994) (citing *Booker v. Brown & Williamson Tobacco Co.*, 879 F.2d 1304, 1310 (6th Cir.1989)). The evidence and all inferences therefrom must be construed in the light most favorable to the non-moving party. *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986); *Enertech Elec., Inc. v. Mahoning County Comm'rs*, 85 F.3d 257, 259 (6th Cir.1996); *Wilson v. Stroh Companies, Inc.*, 952 F.2d 942, 945 (6th Cir.1992). "[T]he mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986); *see also Hartleip v. McNeilab, Inc.*, 83 F.3d 767, 774 (6th Cir.1996).

If the movant establishes by use of the material specified in Rule 56(c) that there is no genuine issue of material fact and that it is entitled to judgment as a matter of law, the opposing party must come forward with "specific facts showing that there is a genuine issue for trial." *First Nat'l Bank v. Cities Serv. Co.*, 391 U.S. 253, 270, 88 S.Ct. 1575, 20 L.Ed.2d 569 (1968); *see also Adams v. Philip Morris, Inc.*, 67 F.3d 580, 583 (6th Cir.1995). Mere allegations or denials in the non-movant's pleadings will not meet this burden. *Anderson*, 477 U.S. at 248, 106 S.Ct. 2505. Further,

the non-moving party cannot rest on its pleadings to avoid summary judgment. It must support its claim with some probative evidence. *Kraft v. United States,* 991 F.2d 292, 296 (6th Cir.), *cert. denied,* 510 U.S. 976, 114 S.Ct. 467, 126 L.Ed.2d 419 (1993).

III. *DISCUSSION*

A. *Right of Publicity Claim (Count I)*

In Count I of the complaint, plaintiff alleges that defendants' use of her name violates her common law right of publicity. The right of publicity protects a celebrity's commercial interest in her identity. "The theory of the right is that a celebrity's identity can be valuable in the *promotion of products,* and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity." *Carson v. Here's Johnny Portable Toilets, Inc.,* 698 F.2d 831, 835 (6th Cir.1983) (emphasis added). The right of publicity, however, does not authorize a celebrity to prevent the use of her name in an expressive work protected by the First Amendment. 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §§ 28:40-28:41 (4th ed.1999); *see also Hicks v. Casablanca Records,* 464 F.Supp. 426, 430 (S.D.N.Y.1978) ("[M]ore so than posters, bubble gum cards, or some other such 'merchandise,' books and movies are vehicles through which ideas and opinions are disseminated and, as such, have enjoyed certain constitutional protections, not generally accorded 'merchandise.' "); *Paulsen v. Personality Posters, Inc.,* 59 Misc.2d 444, 450, 299 N.Y.S.2d 501, 508 (1968) ("[E]ven where the 'right of publicity' is recognized, it does not invest

a prominent person with the right to exploit financially every public use of name or picture. What is made actionable is the unauthorized use for advertising purposes in connection with the sale of a commodity.").[3] Clearly, "[m]usic, as a form of expression and communication, is protected under the First Amendment." *Ward v. Rock Against Racism,* 491 U.S. 781, 790, 109 S.Ct. 2746, 105 L.Ed.2d 661 (1989); *see also Hurley v. Irish-American Gay, Lesbian and Bisexual Group,* 515 U.S. 557, 569, 115 S.Ct. 2338, 132 L.Ed.2d 487 (1995) (paintings, music and poetry are "unquestionably shielded" by the First Amendment).

Similarly, titles of artistic works that use the names of public figures and celebrities, like the works themselves, are entitled to First Amendment protection from right of publicity claims:

> Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and

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3. *Cf. Abdul-Jabbar v. General Motors Corp.,* 85 F.3d 407 (9th Cir.1996) (involved use of basketball player's name in an automobile advertisement); *Winterland Concessions Co. v. Sileo,* 528 F.Supp. 1201 (N.D.Ill.1981), *aff'd,* 830 F.2d 195 (7th Cir.1987) (involved the use of names of entertainers and musical groups on t-shirts); *Uhlaender v. Henricksen,* 316 F.Supp. 1277 (D.Minn.1970) (involved use of major league baseball players' names in connection with a board game); *Palmer v. Schonhorn Enter., Inc.,* 96 N.J.Super. 72, 232 A.2d 458 (1967) (involved use of a golf player's name and likeness in connection with a golf game).

> commercial elements of titles are inextricably intertwined. Film-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works. Furthermore, their interest in freedom of artistic expression is shared by their audience. The subtleties of a title can enrich a reader's or a viewer's understanding of a work.

Rogers v. Grimaldi, 875 F.2d 994, 998 (2d Cir.1989). Furthermore, no publicity claim exists when a celebrity's name is used in advertisements for a work protected by the First Amendment. *See, e.g., Guglielmi v. Spelling-Goldberg Prods.,* 25 Cal.3d 860, 873, 160 Cal.Rptr. 352, 603 P.2d 454, 462 (1979) (Bird, C.J., concurring) ("Since the use of Valentino's name and likeness in the film was not an actionable infringement of Valentino's right of publicity, the use of his identity in advertisements for the film is similarly not actionable.").

The right of publicity is therefore inapplicable under the First Amendment if the content of an expressive work bears *any* relationship to the use of a celebrity's name. *Rogers,* 875 F.2d at 1004 (right of publicity unavailable unless use of celebrity's name is "wholly unrelated" to the work). In addition, the right of publicity does not bar the use of a celebrity's name in a title as long as the item is a literary work and not " 'simply a disguised commercial advertisement for the sale of goods or services.'" *Id.* (quoting *Frosch v. Grosset & Dunlap, Inc.,* 75 A.D.2d 768, 769, 427 N.Y.S.2d 828, 829 (1980)).

In this case, plaintiff repeatedly contends that defendants' "Rosa Parks" song is not expressly "about" her or her civil

rights efforts, concluding that the song's title is "unrelated" to its content and must thus have been selected "solely to attract attention." The court finds plaintiff's argument unpersuasive and unsupportable. There can be no reasonable dispute that Rosa Parks is universally known for and commonly associated with her refusal in late 1955 to obey the segregation laws in Montgomery, Alabama and "move to the back of the bus." The song at issue makes unmistakable reference to that symbolic act a total of ten times. Admittedly, the song is not about plaintiff in a strictly biographical sense, but it need not be. Rather, defendants' use of plaintiff's name, along with the phrase "move to the back of the bus," is metaphorical and symbolic. As a matter of law, this obvious relationship between the content of the song and its title bearing plaintiff's name renders the right of publicity inapplicable.

Moreover, that plaintiff (and even the court) may find defendants' music "profane and vulgar" and not regard it as artistically serious is of no consequence:

> It is fundamental that courts may not muffle expression by passing judgment on its skill or clumsiness, its sensitivity or coarseness; nor on whether it pains or pleases. It is enough that the work is a form of expression "deserving of substantial freedom both as entertainment and as a form of social and literary criticism."

University of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp., 22 A.D.2d 452, 458, 256 N.Y.S.2d 301, 307, *aff'd*, 15 N.Y.2d 940, 259 N.Y.S.2d 832, 207 N.E.2d 508

(1965). Given that the court may not "pass on literary categories, or literary judgment," defendants' song enjoys First Amendment protection as long as it is a "[musical] work and not simply a disguised commercial advertisement for the sale of goods or services." *Frosch,* 75 A.D.2d at 769, 427 N.Y.S.2d at 829 (holding that right of publicity did not apply to book entitled "Marilyn" and rejecting alleged distinction between a "biography" about Marilyn Monroe and "fiction"). Because the necessary linkage between title and content is easily satisfied here, plaintiff would be hard-pressed to demonstrate that defendants' use of her name as the title to their song is "simply a disguised commercial advertisement" to sell a product, especially considering the song has received widespread acclaim and was nominated for a Grammy Award. This result is not altered by defendants' promotion of their album and hit single because the fundamental right to free expression would be illusory if defendants were permitted to entitle their song "Rosa Parks," but not advertise it to the public. The law imposes no such artificial limitation. *See, e.g., Groden v. Random House, Inc.,* 61 F.3d 1045, 1050-51 (2d Cir.1995) (use of author's photograph to promote critical work did not infringe right of publicity); *Guglielmi,* 25 Cal.3d at 873, 160 Cal.Rptr. 352, 603 P.2d at 462 ("It would be illogical to allow respondents to exhibit the film but effectively preclude any advance discussion or promotion of their lawful enterprise."); *Namath v. Sports Illustrated,* 48 A.D.2d 487, 488, 371 N.Y.S.2d 10, 11 (1975), *aff'd,* 39 N.Y.2d 897, 386 N.Y.S.2d 397, 352 N.E.2d 584 (1976) ("The use of plaintiff's photograph was merely incidental advertising of defendants' magazine in which plaintiff had earlier been properly and fairly depicted.").

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Plaintiff also contends that because her name was not used in the news, to educate, for scholarly purposes or as a parody, defendants' use is not protected by the First Amendment. However, the Supreme Court has expressly rejected such a notion and held that entertainment is entitled to the same constitutional protection as the exposition of ideas: "The line between the informing and the entertaining is too elusive for the protection of the basic right." *Winters v. New York,* 333 U.S. 507, 510, 68 S.Ct. 665, 92 L.Ed. 840 (1948). Next, plaintiff incorrectly argues that First Amendment concerns are not implicated here because defendants' use of plaintiff's name was unnecessary and done only to sell their album.

> If this analysis were used to determine whether an expression is entitled to constitutional protection, grave harm would result. Courts would be required not merely to determine whether there is some minimal relationship between the expression and the celebrity, but to compel the author to justify the use of the celebrity's identity. Only upon satisfying a court of the necessity of weaving the celebrity's identity into a particular publication would the shadow of liability and censorship fade. Such a course would inevitably chill the exercise of free speech limiting not only the manner and form of expression but the interchange of ideas as well.

Guglielmi, 25 Cal.3d at 869, 160 Cal.Rptr. 352, 603 P.2d at 460 (citation omitted).

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In her final attempt to convince the court that the First Amendment does not shield defendants from liability on her publicity claim, plaintiff states: "If Defendants [sic] position is carried forward, then the Ku Klux Klan, skinheads or any race supremacist group can exploit the names of others." Indeed, the possibly offensive use by such groups of a celebrity's name is *exactly* the type of speech protected by the First Amendment, which would be a poor refuge for free expression if public figures could censor the use of their names whenever they found the speech to be distasteful. To the contrary, the First Amendment empowers *the audience* to regulate expressive speech. "[P]rominence invites creative comment. Surely, the range of free expression would be meaningfully reduced if prominent persons in the present and recent past were forbidden topics for the imaginations of authors." *Guglielmi,* 25 Cal.3d at 869, 160 Cal.Rptr. 352, 603 P.2d at 460. Thus, plaintiff's argument that this is "simply a property case" is offensive to the First Amendment. Accordingly, because the title "Rosa Parks" is not "wholly unrelated" to defendants' song, and because the title is the name of an expressive work and not a disguised commercial for a product, the right of publicity does not apply to the undisputed facts of this case, which necessitates dismissal of Count I in plaintiff's complaint.

B. *Lanham Act and State Law Unfair Competition Claims (Counts II and V)*

Plaintiff also raises a claim under the Lanham Act, 15 U.S.C. § 1125 (Count II), and a related state law unfair competition claim (Count V). Section 1125(a)(1)(A) provides:

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> Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Like the right of publicity, the Lanham Act ordinarily applies to commercial transactions involving ordinary goods and services, not expressive works in which First Amendment concerns are paramount. Thus, even if the legitimate goals of the Lanham Act and state unfair competition laws in preventing consumer confusion are implicated by the undisputed facts of this case, they are outweighed as a matter of law by defendants' right to freedom of expression.

The court is well aware that "[p]oetic license is not without limits." *Rogers v. Grimaldi,* 875 F.2d 994, 997 (2d Cir.1989). Nonetheless,

> in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion

> outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has *no artistic relevance to the underlying work whatsoever,* or, if it has some artistic relevance, unless the title *explicitly* misleads as to the source or the content of the work.

Id. at 999 (emphasis added).

As discussed above, the direct artistic relevance between the title "Rosa Parks" and the content of defendants' song is so obvious that the matter is not open to reasonable debate. Furthermore, it is abundantly clear that the title does not "explicitly" mislead as to source or content. Examples of blatantly misleading titles might include: "Nimmer on Copyright," "Jane Fonda's Workout Book," a title "explicitly signifying endorsement, such as the phrase in a subtitle 'an authorized biography,'" or "The True Life Story of Ginger and Fred." *Id.* at 999-1000. Where such overt references are used in a title and are false as applied to the underlying work, the consumer's interest in avoiding deception might warrant application of the Lanham Act.

Many titles, however, include a well-known name without any overt indication of authorship or endorsement—for example, the hit song "Bette Davis Eyes" and the recent film "Come Back to the Five and Dime, Jimmy Dean, Jimmy Dean." To some people, these titles might implicitly suggest that the named celebrity had endorsed the work or had a role in producing it. Even if that suggestion is false, the title is

artistically relevant to the work. In these circumstances, *the slight risk that such use of a celebrity's name might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression, and the Lanham Act is not applicable.*

> Similarly, . . . many titles with a celebrity's name make no explicit statement that the work is about that person in any direct sense; the relevance of the title may be oblique and may become clear only after viewing or reading the work. As to such titles, *the consumer interest in avoiding deception is too slight to warrant application of the Lanham Act.* Though consumers frequently look to the title of a work to determine what it is about, they do not regard titles of artistic works in the same way as the names of ordinary commercial products. . . . [M]ost consumers are well aware that they cannot judge a book solely by its title any more than by its cover.

Id. (emphasis added) (citations omitted).

By entitling their song "Rosa Parks," defendants made no explicit representation that their work was endorsed by or affiliated with plaintiff.[4] Nevertheless, plaintiff contends

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4. By contrast, in *Cher v. Forum International, Ltd.*, 692 F.2d 634 (9th Cir.1982), *cert. denied*, 462 U.S. 1120, 103 S.Ct. 3089, 77 L.Ed.2d 1350 (1983), relied upon by plaintiff, the defendant explicitly misrepresented that Cher had granted an "exclusive" interview and endorsed the magazine. Similarly, in *National Bank of Commerce v.*

(Cont'd)

that defendants' use of her name on the cover of their album creates a grave likelihood of confusion because she recently licensed the use of her name in connection with an album of gospel recordings entitled "Verity Records Presents: A Tribute to Mrs. Rosa Parks." To support her claim of likelihood of confusion, plaintiff submitted approximately 20 affidavits from consumers who were allegedly confused as to the source or content of defendants' album. However, plaintiff's anecdotal evidence, assuming its validity, indicates at most that some members of the public might draw the incorrect inference that plaintiff had some involvement with defendants' album. "But that risk of misunderstanding, *not engendered by any overt claim in the title,* is so outweighed by the interests in artistic expression as to preclude application of the Lanham Act." *Id.* at 1001; *see also DeClemente v. Columbia Pictures Indus., Inc.,* 860 F.Supp. 30, 52 (E.D.N.Y.1994) ("[E]ven if the plaintiff's allegations of secondary meaning and consumer confusion are true, the defendants' first amendment interest in naming their films outweighs the plaintiff's and even the public's interest in preventing consumer confusion.").[5]

(Cont'd)

Shaklee Corp., 503 F.Supp. 533 (W.D.Tex.1980), the plaintiff's name was used without permission in an explicit "endorsement" of products, and in *Fairfield v. American Photocopy Equipment Co.,* 138 Cal.App.2d 82, 291 P.2d 194 (1955), the defendant explicitly misrepresented that the plaintiff was a "satisfied user" of defendant's products.

5. Furthermore, in conventional "product" trademark cases, "merely occasional" instances of alleged actual confusion do not support the existence of likelihood of confusion. *See, e.g., S.C. Johnson & Son, Inc. v. Johnson,* 266 F.2d 129, 141 (6th Cir.), *cert. denied,* 361 U.S. 820, 80 S.Ct. 65, 4 L.Ed.2d 65 (1959).

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Moreover, defendants' album and its packaging unequivocally identify defendants as the source of the album. "The most common and effective means of apprising intending purchasers of the source of goods is a prominent disclosure on the container, package, wrapper, or label of the manufacturer's or trader's name . . . [and when] that is done, there is no basis for a charge of unfair competition." *Versa Prods. Co., Inc. v. Bifold Co. (Mfg.) Ltd.*, 50 F.3d 189, 203 (3d Cir.), *cert. denied*, 516 U.S. 808, 116 S.Ct. 54, 133 L.Ed.2d 19 (1995). In other words, "the plaintiff's right can be protected sufficiently by requiring the defendant's [products] to be clearly marked so as to indicate unmistakably that they are defendant's and not the plaintiff's goods." *Flagg Mfg. Co. v. Holway*, 178 Mass. 83, 91, 59 N.E. 667, 667 (1901). Given the prominent appearance of defendant Outkast's name on their album, there can be no likelihood of confusion under the Lanham Act between plaintiff's and defendants' albums as a matter of law.[6]

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6. Compare the Lanham Act cases cited by plaintiff all of which involved the use of famous persons' names in connection with recordings by them, thereby directly and intentionally misrepresenting that the plaintiffs had approved the unauthorized distributions of their work. *See PPX Enter., Inc. v. Audiofidelity Enter., Inc.*, 818 F.2d 266, 268 (2d Cir.1987) (defendants marketed eight albums allegedly containing feature performances by the electric guitarist Jimi Hendrix, when in fact the albums "either did not contain Hendrix performances at all or contained performances in which Hendrix was merely a background performer or undifferentiated session player"); *Apple Corps Ltd. v. Adirondack Group*, 124 Misc.2d 351, 355, 476 N.Y.S.2d 716, 719 (1983) (defendants distributed "recordings of inferior quality which were made as a lark"); *Benson v. Paul Winley Record Sales Corp.*, 452 F.Supp. 516, 518 (S.D.N.Y.1978)

(Cont'd)

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Likewise, plaintiff's state law unfair competition claim also fails.[7] As a threshold matter, plaintiff cannot proceed under M.C.L. § 429.42[8] because application of that statute contemplates a state registered trademark, which plaintiff does not have. Furthermore, plaintiff has not established that she has any common law trademark rights in her name,

(Cont'd)
(defendants "made [the plaintiff] to appear as the central and controlling artist when in fact he was not," and also misrepresented to the public that the songs on the album were recent releases by the plaintiff). On the other hand, defendants here have not used plaintiff's name on a work by plaintiff, nor have defendants misappropriated any written or recorded material of plaintiff's.

7. The Sixth Circuit noted in *Carson v. Here's Johnny Portable Toilets, Inc.*, that Lanham Act and Michigan state law unfair competition claims were both governed by the same standards. 698 F.2d at 833; *see also Sports Auth., Inc. v. Abercrombie & Fitch, Inc.*, 965 F.Supp. 925, 934 n. 5 (E.D.Mich.1997) ("the Court's analysis under the Lanham Act will also apply to [plaintiff's Michigan] common law claim").

8. M.C.L. § 429.42 states in relevant part:

> [A]ny person who shall:
>
> (a) Use, without the consent of the registrant, any reproduction, counterfeit, copy or colorable imitation *of a mark registered under this act* in connection with the sale, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive as to the source of origin of such goods or services . . . is liable to a civil action *by the owner of the registered mark.*

(emphasis added).

or that defendants made any trademark use of her name.[9] In fact, plaintiff conceded during oral argument that she cannot maintain an action for trademark infringement. Finally, plaintiff cites the following from the *Restatement (Third) of Unfair Competition* §§ 46-47 (1995):

> One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability. . . . The name, likeness, and other indicia of a person's identity are used "for purposes of trade" . . . if they are used in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user.

Plaintiff's purported reliance on the Restatement lacks credit, however, considering she neglected to mention the portion that unambiguously distinguishes it from this case: "However, uses 'for purposes of trade' does not ordinarily include the use of a person's identity in news reporting, commentary, entertainment, works of fiction or nonfiction,

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9. "[W]hether alleging infringement of a registered trademark . . . or infringement of an unregistered trademark . . . , it is clear that a plaintiff must show that it has actually used the designation at issue as a trademark, and that the defendant has also used the same or a similar designation as a trademark." *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753 (6th Cir.1998). Compare defendants' use of plaintiff's name here for the purpose of sending an artistic message, with a hypothetical claim by defendants that they were selling "Rosa Parks"-brand discs and cassettes.

or in advertising that is incidental to such uses." *Id.* § 47. As a public figure, plaintiff simply is not entitled to control every conceivable presentation of her name and likeness. Consequently, defendants are entitled to summary judgment as to plaintiff's unfair competition and Lanham Act claims.

C. *Defamation Claim (Count III)*

Next, plaintiff asserts a claim for defamation in Count III of her complaint. Specifically, plaintiff alleges that defendants "used derogatory and offensive language in their lyrics and associated said language with Plaintiff's 'persona,' character and name without her consent," thereby "cast[ing] Plaintiff in a false and unacceptable light." The requisite elements of a defamation claim in Michigan include: (1) a false and defamatory statement to a third party; (2) an unprivileged statement; (3) fault amounting to at least negligence; and, (4) either actionability of statements irrespective of special harm, or existence of special harm caused by the publication. *Andrews v. Prudential Sec., Inc.*, 160 F.3d 304, 308 (6th Cir.1998); *Rouch v. Enquirer & News*, 427 Mich. 157, 173-74, 398 N.W.2d 245, 252 (1986). In addition, the Constitutional guarantee of free expression limits the scope of state defamation laws. *New York Times Co. v. Sullivan*, 376 U.S. 254, 84 S.Ct. 710, 11 L.Ed.2d 686 (1964); *see also Milkovich v. Lorain Journal Co.*, 497 U.S. 1, 14, 110 S.Ct. 2695, 111 L.Ed.2d 1 (1990). The First Amendment prohibits public figures from recovering damages for a false and defamatory statement unless the statement was made with actual malice. *Sullivan*, 376 U.S. at 279-80, 84 S.Ct. 710. To meet the actual malice standard, plaintiff must show by clear and convincing evidence that a

false statement was made with knowledge of the falsity or with reckless disregard for the truth. *See Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 342, 94 S.Ct. 2997, 41 L.Ed.2d 789 (1974); *Sullivan*, 376 U.S. at 280, 84 S.Ct. 710.

In order to safeguard freedom of expression and prevent the chilling effect imposed upon it by extensive litigation, this court shall conduct an independent review of all allegedly defamatory statements to determine, as a matter of law, whether the material is actionable. *Garvelink v. Detroit News*, 206 Mich.App. 604, 609, 522 N.W.2d 883, 886 (1994), *appeal denied*, 448 Mich. 948, 534 N.W.2d 530 (1995) ("We are required to conduct an independent review of [the allegedly defamatory matter] to ensure against the forbidden intrusion on the field of free expression and to examine the statements and the circumstances under which they were made."). A statement is actionable if it is "provable as false," and understandable as stating actual facts about the complainant. *Milkovich*, 497 U.S. at 16-17, 19-20, 110 S.Ct. 2695; *see also Greenbelt Coop. Publ'g Ass'n v. Bresler*, 398 U.S. 6, 13-14, 90 S.Ct. 1537, 26 L.Ed.2d 6 (1970) (recognizing that some statements, read in context, are not capable of defamatory interpretation).

A careful review of defendants' entire "Rosa Parks" song reveals that it manifestly contains no factual statements, false or otherwise, about plaintiff. In fact, no reasonable person could interpret any of the lyrics as stating actual facts about plaintiff. Rather, the song only references plaintiff indirectly through the refrain "Ah ha, hush that fuss, Everybody move

to the back of the bus."[10] Furthermore, because no portion of defendants' song can be construed as a false factual statement about plaintiff, she, as a public figure, could never prove actual malice. Thus, her defamation claim necessarily fails.

Plaintiff's alternative reliance on the closely-related theory of false light invasion of privacy is likewise of no avail. To state a false light claim, plaintiff must demonstrate that defendants "broadcast to the public in general, or to a large number of people, information that was unreasonable and highly objectionable by attributing to the plaintiff characteristics, conduct, or beliefs that were false and placed the plaintiff in a false position." *Porter v. Royal Oak,* 214 Mich.App. 478, 486-87, 542 N.W.2d 905, 909 (1995), *appeal denied,* 453 Mich. 977, 557 N.W.2d 315 (1996) (quoting *Duran v. Detroit News, Inc.,* 200 Mich.App. 622, 631-32, 504 N.W.2d 715, 720-21 (1993), *appeal denied,* 444 Mich. 944, 512 N.W.2d 846 (1994)). However, just as with defamation claims, "[if] a statement cannot be reasonably interpreted as stating actual facts about the plaintiff, it is protected by the First Amendment," and thus not actionable for false light invasion of privacy. *Ireland v. Edwards,* 230 Mich.App. 607, 614, 584 N.W.2d 632, 636 (1998). Additionally, "this cause of action cannot succeed if the contested statements are true." *Porter,* 214 Mich.App. at 487, 542 N.W.2d at 909. "Indeed, any other conclusion would

10. To the extent that the chorus could somehow be conceived as a direct reference to plaintiff, it constitutes an accurate historical reference to her refusal in 1955 to give up her seat and move to the back of bus, and truth serves as an absolute defense to defamation claims. *See Porter v. Royal Oak,* 214 Mich.App. 478, 486, 542 N.W.2d 905, 909 (1995).

allow a plaintiff to circumvent the First Amendment limitations, and would effectively eliminate the 'breathing space' required for freedom of expression." *Ireland,* 230 Mich.App. at 625 n. 15, 584 N.W.2d at 641 n. 15.

Because the court has already determined that plaintiff cannot overcome the First Amendment limitations regarding defendants' "Rosa Parks" song, she is unable to establish that defendants portrayed her in a false light. Actually, it is beyond comprehension how defendants' song could attribute to plaintiff any false characteristics or beliefs when the song plainly does not portray her at all. Accordingly, plaintiff's objection to the use of her name in conjunction with an artistic work containing allegedly "profane" language must give way to defendants' First Amendment right to comment on public figures, regardless of whether the commentary meets with agreement or approval.

Similarly, plaintiff's resort to the rarely-successful cause of action for defamation by implication is also without merit. While true that "Michigan common law recognizes defamation by implication, . . . '*[a] plaintiff alleging [such a claim] must still prove material falsity.*' " *Hawkins v. Mercy Health Serv., Inc.,* 230 Mich.App. 315, 329, 583 N.W.2d 725, 731-32, *appeal dismissed,* 589 N.W.2d 773 (Mich.1998) (quoting *Locricchio v. Evening News Ass'n,* 438 Mich. 84, 130, 476 N.W.2d 112, 132 (1991), *cert. denied,* 503 U.S. 907, 112 S.Ct. 1267, 130 L.Ed.2d 907 (1992)). Again, plaintiff cannot demonstrate the existence of any false implications flowing from defendants' song because to the extent the song implicates her, it accurately references admitted conduct by her. Moreover, the fact that defendants

titled their song "Rosa Parks" does not, as plaintiff contends, signify her endorsement of the "offensive" language contained therein. Instead, defendants' use of plaintiff's name connotes their engagement in the fundamental right to free expression. "[I]n defamation cases, the concern is with defamatory lies masquerading as truth." *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal.3d 860, 871, 160 Cal.Rptr. 352, 603 P.2d 454, 461 (1979) (Bird, C.J., concurring). By contrast, the musician who creates an expressive work with a symbolic title proclaims his artistic license and indifference to "the facts." "There is no pretense." *Id.* For all of these reasons, summary judgment in defendants' favor is appropriate as to Count III.

D. *Intentional Infliction of Emotional Distress Claim (Count IV)*

Count IV states a claim for intentional infliction of emotional distress. To prevail on such a claim, plaintiff must prove: (1) extreme and outrageous conduct; (2) intent or recklessness; (3) causation; and, (4) severe emotional distress. *Andrews v. Prudential Sec., Inc.*, 160 F.3d 304, 309 (6th Cir.1998). "Extreme and outrageous conduct" is "'so outrageous in character, and so extreme in degree, as to go beyond all possible bounds of decency, and to be regarded as atrocious, and utterly intolerable in a civilized community.'" *Id.* (quoting *Roberts v. Auto-Owners Ins. Co.*, 422 Mich. 594, 602-03, 374 N.W.2d 905, 908-09 (1985)). Furthermore, liability arises only where "'the distress inflicted is so severe that no reasonable man could be expected to endure it.'" *Id.*

"The trial court must determine as a matter of law whether the defendant's conduct was so extreme and outrageous to withstand a motion for summary disposition." *Duran v. Detroit News, Inc.*, 200 Mich.App. 622, 630, 504 N.W.2d 715, 720 (1993), *appeal denied*, 444 Mich. 944, 512 N.W.2d 846 (1994) (affirming dismissal of intentional infliction of emotional distress claim). In this case, defendants' exercise of their First Amendment right to title a song "Rosa Parks" can hardly be considered extreme and outrageous. *Cf. Hustler Magazine v. Falwell*, 485 U.S. 46, 50, 108 S.Ct. 876, 99 L.Ed.2d 41 (1988) (Court denied Jerry Falwell's claim of intentional infliction of emotional distress over a parody depicting him engaged in incest and alcohol abuse, holding that a state's interest in preventing emotional distress to public figures is not "sufficient to deny First Amendment protection to speech that is patently offensive and is intended to inflict emotion injury . . . when that speech could not reasonably have been interpreted as stating actual facts about the public figure involved"). Count IV must therefore be dismissed as a matter of law.

E. *Intentional Interference with Business Relations Claim (Count VI)*

Plaintiff also asserts a claim for intentional interference with an advantageous business relationship, contending that defendants' "unauthorized use of her name in the present context will substantially interfere with sale and distribution of the authorized [tribute gospel] recording."

> The basic elements of tortious interference with a business relationship are the existence of a valid

> business relation or expectancy, knowledge of the relationship or expectancy on the part of the interferer, an intentional interference inducing or causing a breach or termination of the relationship or expectancy, and resultant damage to the party whose relationship has been disrupted.

Lakeshore Community Hosp., Inc. v. Perry, 212 Mich.App. 396, 401, 538 N.W.2d 24, 27 (1995). Plaintiff must further show the "intentional doing of a per se wrongful act or the intentional doing of a lawful act with malice and unjustified in law for the purpose of invading plaintiff's contractual rights or business relationship." *Chrysler Int'l Corp. v. Cherokee Export Co.,* 134 F.3d 738, 745 (6th Cir.1998). "'Malice' in the legal sense is the intentional doing of a wrongful act without justification or excuse. And a 'wrongful' act is any act which in the ordinary course will infringe upon the rights of another to his damage, except it be done in the exercise of an equal or superior right." *Id.*

In the present matter, plaintiff does not allege that defendants caused the breach of any contract to which she is a party. Instead, plaintiff rests her claim entirely on *Stormor v. Johnson,* 587 F.Supp. 275 (W.D.Mich.1984), holding that a cause of action for tortious interference might be stated by allegations that a defendant caused the performance of a third party under contract to be more expensive or burdensome. *Id.* at 282. However, as acknowledged in *Stormor,* "no Michigan court has specifically recognized [such] a cause of action," *id.,* nor has any Michigan court done so in the intervening 15 years. Furthermore, the *Stormor* court did not

determine that the plaintiff should prevail on its theory; rather, the court merely declined to dismiss that aspect of the complaint on the defendant's motion. *Id.*

Even if this court were to follow *Stormor,* instead of using the test universally applied by Michigan courts that requires plaintiffs to demonstrate an actual contractual breach by a third party, plaintiff's tortious interference claim still fails. First, plaintiff has no evidence to support her conclusory allegation that the continued sales of defendants' song "would make it more disruptive, expensive and burdensome for the sale of the tribute gospel album to flourish in the marketplace." In addition, plaintiff's declaration that "all future endeavors . . . to market her name in connection with worthwhile projects are in jeopardy" is equally undocumented. Moreover, Michigan law requires the existence of a *present* contract to succeed on a tortious interference claim. *Admiral Ins. Co. v. Columbia Cas. Ins. Co.,* 194 Mich.App. 300, 312-13, 486 N.W.2d 351, 358 (1992), *appeal denied sub nom. Admiral Ins. Co. v. Brochert,* 442 Mich. 917, 503 N.W.2d 449 (1993). Plaintiff's supposition that she will be unable to enter into prospective contracts thus precludes the relief sought. More importantly, however, defendants clearly have not engaged in any per se wrongful conduct by permissibly titling their song "Rosa Parks." Nor have defendants committed any lawful act with malice that is unjustified in law. Accordingly, defendants are entitled to summary judgment as to Count VI.

Appendix B

F. *Remaining State Law Claims (Counts VII-IX)*

Plaintiff's remaining claims include: unjust enrichment (Count VII); negligence (Count VIII); and, conspiracy (Count IX). Because all three claims incorrectly presuppose a legal duty not to use plaintiff's name as defendants did, they too must be dismissed.

To pursue an action for unjust enrichment in Michigan, plaintiff must show (1) the receipt of a benefit by defendants from plaintiff; and, (2) that it is inequitable for defendants to retain such benefit. *Rothschild v. Ford Motor Co.*, 2 F.Supp.2d 941, 951-52 (E.D.Mich.1998) (citing *B & M Die Co. v. Ford Motor Co.*, 167 Mich.App. 176, 181, 421 N.W.2d 620, 622 (1988)). Even assuming arguendo that some financial benefit received by defendants from their *Aquemini* album can be attributed to the use of plaintiff's name as the title to one of 15 songs included therein, defendants had a clear First Amendment right to title their song "Rosa Parks." Consequently, it is not inequitable for defendants to retain any such "benefit" resulting from the *Aquemini* album, and they have not been unjustly enriched.

Next, in order to maintain a negligence claim, plaintiff must prove that (1) defendants owed her a legal duty; (2) defendants breached that duty; (3) plaintiff suffered damages; and, (4) the breach was the proximate cause of the damages suffered. *Pitsch v. ESE Mich., Inc.*, 233 Mich.App. 578, 593 N.W.2d 565, 575, *appeal denied*, 595 N.W.2d 844 (Mich.1999). Plaintiff, however, has failed to establish that defendants owed her any legal duty, considering no contractual or other relationship ever existed between the parties.

Finally, under Michigan law, "'the gist or gravamen of [a civil conspiracy] action is not the conspiracy but is the wrongful acts causing the damages. The conspiracy standing alone without the commission of acts causing damage would not be actionable.'" *Glidden Co. v. Jandernoa,* 5 F.Supp.2d 541, 555 (W.D.Mich.1998) (quoting *Roche v. Blair,* 305 Mich. 608, 614, 9 N.W.2d 861, 863 (1943)). Because defendants have not engaged in any wrongful acts, no actionable conspiracy exists.

IV. *CONCLUSION*

The undisputed facts in this case require that summary judgment be granted in defendants' favor. Therefore,

IT IS ORDERED that plaintiff's motion for summary judgment and injunctive relief hereby is DENIED.

IT IS FURTHER ORDERED that defendants' motion for summary judgment hereby is GRANTED.

APPENDIX C — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT DENYING PETITION FOR REHEARING FILED JULY 2, 2003

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

No. 99-2495

ROSA PARKS,

Plaintiff-Appellant,

v.

LAFACE RECORDS, ET AL.,

Defendants-Appellees.

ORDER

BEFORE: NORRIS and COLE, Circuit Judges; and HOLSCHUH,* District Judge.

The court having received a petition for rehearing en banc, and the petition having been circulated not only to the original panel members but also to all other active judges of this court, and no judge of this court having requested a vote on the suggestion for rehearing en banc, the petition for rehearing has been referred to the original panel.

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* Hon. John D. Holschuh, Senior United States District Judge for the Southern District of Ohio, sitting by designation.

Appendix C

The panel has further reviewed the petition for rehearing and concludes that the issues raised in the petition were fully considered upon the original submission and decision of the case. Accordingly, the petition is denied.

ENTERED BY ORDER OF THE COURT

s/ Leonard Green
Leonard Green, Clerk

APPENDIX D — CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

U.S. Const. Amend. I

Congress shall make no law . . . abridging the freedom of speech or of the press. . . .

15 U.S.C. § 1125. False designation of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which —

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.